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No. 05-

In the Supreme Court of the United States

BERNARD F. DEPALMA,

Petitioner,

v.

NIKE, INC., BAUER NIKE HOCKEY, INC., AND BAUER NIKE HOCKEY USA,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether a district court may grant summary judgment *sua sponte* on a ground not raised in a FED.R.CIV.P. 56 motion, without providing prior notice specifying the portions of the record and specifically pointing out the material facts that are believed to be undisputed and upon which judgment as a matter of law will be based?

2. Whether the burden that shifts to the opposing party, pursuant to *Celotex v. Catrett*, 477 U.S. 317 (1986), to come forward with all of its evidence in opposition to summary judgment, is circumscribed by the specific points and contentions of undisputed facts, raised in the motion or by notice of the court *sua sponte*, or is the opposing party required to muster the evidence supporting all of its claims once on notice that summary judgment is being considered on any ground?

3. Whether a district court must notify the parties of its construction of a legal instrument, such as a contract, a statute, or the claims of an asserted patent pursuant to *Markman v. Westview Instr., Inc.*, 517 U.S. 370 (1996), prior to granting summary judgment upon a limitation or requirement deemed existing in the instrument solely by virtue of the court's *sua sponte* construction?

4. Whether the prohibition against entry of summary judgment *sua sponte*, or without adequate prior notice of the grounds therefor, is mandatory or may be reviewed solely for an abuse of discretion?

5. Whether Rule 36 of the United States Court of Appeals for the Federal Circuit, which permits in certain circumstances the entry of judgment affirming without opinion, and Rule

47.6(b) of that court, which prohibits citation of unpublished opinions but has now been overruled by the new F.R.A.P. 32.1, improperly facilitate the rendering of inconsistent decisions among its panels and deprive parties of judgment according to *stare decisis*, as a matter of expediency, so as to call for an exercise of this Court's supervisory power?

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OPINIONS BELOW

The judgment of the United States Court of Appeals for the Federal Circuit, 05-1140 (Dec. 6, 2005) (App. 3a) and the opinion of the United States District Court for the Northern District of New York, 95-CV-1428 (slip op. July 5, 2001) (App. 13a) which was affirmed, are unpublished. An interim decision of the district court that was entered in conjunction with its judgment is published at 341 F. Supp. 178 (N.D.N.Y. 2004) (App. 7a).

STATEMENT OF JURISDICTION

This Court has jurisdiction to issue the requested writ pursuant to 28 U.S.C. § 1254(1). The Court of Appeals denied petitioner's timely petition for rehearing and rehearing *en banc* by order dated January 24, 2006 (App. 1a).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

FED.R.CIV.P. 56

(b) A party against whom a claim is asserted ... may, at any time, move with or without supporting affidavits for a summary judgment in the party's favor....

(c) The motion shall be served at least 10 days before the time fixed for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and the admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. ...

(e) ...*When a motion for summary judgment is made and supported as provided in this rule,* an adverse party may not rest on the mere allegations or denials of the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If the adverse party does not so respond, summary judgment, if appropriate, shall be rendered against the adverse party. [emphasis added]

Fifth Amendment

No person shall ... be deprived ... of property, without due process of law.

Seventh Amendment

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of a trial by jury shall be preserved ....

Federal Circuit Rule 36

The court may enter judgment of affirmance without opinion, citing this rule, when it determines that any one of the following conditions exist and an opinion would have no precedential value:

(c) the record supports summary judgment ...;

(e) a judgment or decision has been entered without an error of law.

Federal Circuit Rule 47.6

(a) Disposition of an appeal may be announced in an opinion .... An appeal may also be disposed of in a judgment of affirmance without opinion, pursuant to Federal Circuit Rule 36 ....

(b) An opinion or order which is designated as not to be cited as precedent is one determined by the panel issuing it as not adding significantly to the body of law. Any opinion or order so designated must not be cited as precedent.

New F.R.A.P. 32.1

A court may not prohibit or restrict the citation of federal judicial opinions, orders, judgments or other written dispositions that have been designated as ... "nonprecedential" and ...issued on or after January 1, 2007.

STATEMENT OF THE CASE

Petitioner Bernard F. DePalma seeks certiorari review of the judgment of the Court of Appeals for the Federal Circuit affirming, pursuant to 28 U.S.C. § 1295(a)(1), the final decision of the District Court for the Northern District of New York granting summary judgment in a patent infringement action brought pursuant to 35 U.S.C. § 271, *et seq.*, over which the district courts have exclusive jurisdiction pursuant to 28 U.S.C. § 1338(a).

This petition raises important questions regarding the protections afforded by FED.R.CIV.P. 56, as it has been construed by this Court in *Celotex v. Catrett, supra*, when a district court grants summary judgment on a ground neither raised in a motion nor of which the court afforded the aggrieved party notice prior to its entry of summary judgment *sua sponte* on that ground. These questions take on particular significance where, as here, the district court, in conjunction with its entry of summary judgment, construed the operative legal instrument or claim (here, petitioner's patent) in a manner that first gave rise to the novel legal ground upon which the court found no disputed fact and determined would entitle his adversary to judgment as a matter of law. Petitioner was thereby deprived of an opportunity to dispute those facts and, ultimately, of Due Process and his Seventh Amendment right to a trial by jury.

Petitioner Bernard F. DePalma is owner of United States Patent No. 4,507,801 for a Protective Garment, an upper body protective device commonly known as the set of "shoulder pads" worn by hockey players. The invention of the DePalma patent is claimed as follows:

1. A protective garment for protecting at least the upper part of the body of an athlete comprising:

a. tightly fitting body covering means made of stretchable material;

b. plurality of pockets affixed to the body covering means;

c. said pockets being located in the portion of the body-covering means covering the body portion to be protected;

d. a plurality of impact-absorbing pad means for protecting a body portion adapted to fit in the pocket means covering the body portion to be protected;

e. each pad means being shaped to conform to the contours of the wearer's body at the portion to be protected, whereby the pad means, fitting into the pocket means, protects a portion of the body by closely conforming to the body, held accurately in place by stretching of body covering means;

f. the garment having pocket means and pad means for insertion therein to cover and protect at least the acromio-clavicular joint of the shoulder;

g. said pocket means and pad means protecting the said acromio-clavicular joint of the shoulder extending downward to the wearer's pectoral and upper trapezius muscles, such that the pad means is bridged over the acromio-clavicular joint of the shoulder, leaving a gap between the top of the wearer's shoulder and the pad means, whereby impact forces are transferred to the

pectoral and trapezius muscles, while allowing free movement of the shoulder. [*See*, App. 22a-23a]

DePalma sued Nike, Inc., its subsidiaries, Bauer, Inc. and Bauer USA (now Bauer Nike Hockey Inc. and Bauer Nike Hockey USA) (together "Bauer") in 1995, after the hockey industry switched from a floppy, hard-shell style shoulder pad to a stretch garment with pads held in its pockets, which DePalma claimed infringed his patent.[1]

In 2000, Bauer moved for summary judgment that they did not infringe claim 1 of the DePalma patent on the following independent grounds, any one of which would have been sufficient to support the judgment, as only one claim element need be absent to avoid infringement. *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., Inc.*, 520 U.S. 17, 29 (1997):

1. Bauer argued that the claimed "body covering means" (claim 1-a) is limited to a typical garment, such as a shirt or vest, and that the Bauer products did not comprise a shirt or vest (App. 30a).

2. Bauer argued that the term, "tightly fitting" (claim 1-a) requires that the individual pads do not shift or move, and that the pads on their products can shift on contact (App. 30a).

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[1] In 1983, DePalma and his co-inventors disclosed the invention and their patent application to Bauers' predecessor, Cooper Canada Ltd., who rejected a license and thereafter formally protested the issuance of the patent in the United States Patent & Trademark Office, contrary to its nondisclosure agreement.

3. Bauer argued that the claimed "pockets" (claim 1-b) must have openings for removal of the individual pads, and that the pockets holding the pads in their products were closed (App. 28a-30a).

4. Bauer argued that the claim language, "shaped to conform to the wearer's body" (claim 1-e, first clause), required the pads to be custom formed to the wearer's body, and that their products were not custom made for the individual (App. 27a-28a).

5. Bauer argued that the pad protecting the acromio-clavicular joint (claim 1-g) must be rigid, spaced from the shoulder, and rest on the chest and back of the wearer, and that their products were not so constructed (App. 31a).

The district court rejected each of Bauer's proffered claim constructions and contentions of non-infringement (App. 27a-31a). Instead, the district court granted summary judgment on a different ground than any raised by Bauer on their motion.[2] Unexpectedly finding, on its own, that the Bauer products had no "discernable" stretch garment material apart from the material defining the pockets of the body covering, in contrast to the preferred embodiment depicted in the patent specification as having substantial unpadded material between the pockets, the district court imported that attribute into the claim as a limitation and ruled that the Bauer products thus did not have separate "body covering means" for holding the

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[2] In its opinion and order of July 5, 2001 (App. 13a), the district court also denied Bauer's motion for summary judgment on its counterclaim for a declaration of patent invalidity. The court did not enter final judgment until November 9, 2004, upon its dismissal of the counterclaim after the patent had expired. *DePalma v. Nike, et al.*, 341 F. Supp. 178 (N.D.N.Y. 2004).

individual pads "accurately in place" (claim 1-e, last clause) and, for that reason, did not infringe:

> The product is essentially made up of the pads themselves, encased in stretch fabric and joined closely together by various means. There is no discernable separate garment apart from the fabric-encased pads. Nor are the pads held against the body by the stretchiness and tight fit of the product; rather, they are held in place by virtue of their incorporation into the shell-like structure of the product.... In contrast, the '801 [DePalma] claims teach a stretch garment, made to fit tightly on the upper body like a shirt or other typical garment for the upper body. Even when the pads are inserted, a significant portion of the garment is not padded, its function being to provide a tight fit on the wearer's body serving to hold the pads firmly in place over the portion of the body to be protected. [App. 33a-34a]

In so doing, the district court committed clear error by (1) construing the DePalma patent claim with the aim of excluding Bauer's products,[3] (2) limiting the patent claim to a drawing of a preferred embodiment,[4] (3) failing to permit the stretch material of the Bauer garments to satisfy both the "body covering" and "pockets" limitation of the claims under

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[3] *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1118 (Fed. Cir. 1985) (*en banc*).

[4] *RF Delaware Corp. v. Pacific Keystone Tech., Inc.*, 326 F.3d 1255, 1264 (Fed. Cir. 2003).

the "all elements" rule,[5] (4) making findings as to the factual disputes whether there was any stretch body-covering material between the pockets of the Bauer garments and whether other stretch material, such as the garment material defining the pockets or the elastic straps, did not hold the individual pads over the body portions to be protected, on the ground that no reasonable juror could have found otherwise,[6] and (5) doing so without prior notice to DePalma. The first four errors described above demonstrate why the court of appeals was wrong in affirming the district court's judgment without an opinion explaining its radical or unusual departure from its prior decisions; while these may not be precedential setting questions of patent law, the court of appeal's departure from its established precedents required an opinion. The fifth error is itself raised as a ground for certiorari.

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[5] *Eagle Comtronics, Inc. v. Arrow Comm. Labs, Inc.*, 305 F.3d 1303, 1317 (Fed. Cir. 2002).

[6] *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1323 (Fed. Cir. 2002). While the Federal Circuit panel at oral argument expressed a novel interest in whether the elastic straps were in fact a part of the garment and contributed to holding the individual pads in place on the wearer, it ignored the district court's deprivation of petitioner's right to submit evidence on that issue, effectively making a *sua sponte* finding on that issue, itself.

REASONS FOR GRANTING THE WRIT

A. The Federal Courts Are Divided on the Questions of Proper Notice Prior to Entry of Summary Judgment and the Scope of the Resulting Evidentiary Burden Placed Upon the Party Opposing Summary Judgment, and the Standard of Review Thereof

In *Celotex v. Catrett*, 477 U.S. 317 (1986), this Court placed a burden upon the party moving for summary judgment to identify the specific grounds upon which it believes it is entitled to judgment as a matter of law:

> Of course, a party seeking summary judgment always bears the initial responsibility of informing the district court of the basis for its motion, and identifying those portions of "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any," which it believes demonstrate the absence of a genuine issue of material fact. [*Id.* at 323]

Shortly after announcing its decision in *Celotex*, this Court reaffirmed the importance of that burden in providing notice to the party against whom summary judgment might be entered:

> As we have mentioned, petitioner's motion for dismissal or for summary judgment was based on the sole ground that an employee's exclusive remedy for a railroad's failure to maintain a safe workplace is to file a grievance under the RLA. Respondent's memorandum, of course, sought to respond to that narrow argument alone, and did not deal with the question whether emotional injury is actionable under

> the FELA.... Had petitioner moved for summary judgment on the ground that FELA does not recognize claims for respondent's type of injury, respondent would have had the opportunity to supplement the record with relevant facts to contest that motion. See Fed.Rule Civ.Proc. 56(c). As we explained last Term, summary judgment is available only when, "after adequate time for discovery and upon motion," the party seeking summary judgment has satisfied its "responsibility of informing the district court of the basis for its motion, and identifying those portions of 'the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any,' which it believes demonstrate the absence of a genuine issue of material fact." *Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 106 S.Ct. 2548, 2553, 91 L.Ed.2d 265 (1986).

Atchison, Topeka & Santa Fe Railway Co. v. Buell, 480 U.S. 557, 568 (1987). The next and last time this Court addressed the issue was in *Crawford-El v. Britton*, 523 U.S. 574, 600 n.22 (1998) ("*if the [movant] has made a properly supported motion* [citing in n. 22 the standard from *Celotex, supra*], the plaintiff may not respond simply with general attacks ... but rather must identify affirmative evidence from which a jury could find that the plaintiff has carried his or her burden" [emphasis added]). By the emphasized language, this Court reaffirmed that a properly supported motion or other adequate notice is not only a prerequisite to shifting the burden to the opposing party, but defines the scope of that burden.[7]

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[7] This Court's recent opinion in *South Florida Water Mgt. Dist. v. Miccosuki Tribe*, 541 U.S. 95, 110-11 (2004), that the record was not sufficiently developed to support the summary judgment the

1. Some Circuits Review the Entry of Summary Judgment *Sua Sponte* and Without Proper Notice for an Abuse of Discretion; Others Deem that Remand Is Mandated by *Celotex*

At the time petitioner briefed his appeal in the Federal Circuit, its opinions in three decisive cases on these issues were unpublished: *Weiss v. Reebok Int'l Ltd.*, 91 Fed. Appx. 683 (Fed. Cir. 2004), *Bemis Mfg. Co. v. Dornoch Medical Systems, Inc.*, 21 Fed. Appx. 930 (Fed. Cir. 2001), and *Colvin v. Nat'l Auto Parts Ass'n*, 1996 WL 274411, 86 F.3d 1179 (table) (Fed. Cir. 1996). Petitioner was therefore prohibited by Federal Circuit Rule 47.6 from citing them to the panel that decided his appeal.

The Federal Circuit, in its unpublished *Weiss* decision and under circumstances quite similar to those in petitioner's case,[8] reversed a summary judgment of non-infringement because it was based upon a ground not presented in the

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district court had entered on a theory not raised by either party, points out the need for clarity and uniformity on this issue.

[8] In *Weiss*, Reebok had moved for summary judgment limited to two grounds of non-infringement, based upon its construction of two structural claim limitations. At a subsequent hearing, Reebok refocused its argument on a different, functional claim limitation, and the district court granted summary judgment on that ground. 91 Fed. Appx. at 688-90. Weiss, therefore, was deprived not only of the opportunity to present affidavits on the factual issue about which the district court found no genuine dispute, but also an opportunity to proffer his construction of that claim element. *Id.* at 690. Petitioner, more egregiously, was deprived of an opportunity to construe his patent claims as *excluding* an element that the district court imported into the claim without prior notice.

motion. But, in so doing, the court applied a lenient standard that comports neither with this Court's precedents nor the standards applied in other circuits: "[s]ummary judgment may be granted on legal grounds other than those advanced by the parties if the record is sufficiently developed." *Id.* at 689.[9] The court then adopted the rule followed in the Sixth Circuit[10] that admonishes the district courts merely to exercise "caution" in granting summary judgment on non-briefed grounds, and that they "normally should" give prior notice

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[9] Generally, the circuits recognize two exceptions to the rule prohibiting summary judgment *sua sponte* without prior notice of the grounds therefor: (1) where the issue is purely a matter of law and (2) where the record is complete as to the facts upon which summary judgment is granted; a "harmless error" exception. *See, Gibson v. City of Wilmington*, 355 F.3d 215, 222-24 (3d Cir. 2004). (*Cf., Powell v. United States*, 849 F.2d 1576 (5th Cir. 1988), for the Fifth Circuit rule strictly applying the notice rule and allowing a "harmless error" exception only where the party against whom summary judgment was entered had expressly admitted that the dispositive fact was undisputed or that it had no further evidence on the issue.) But where, as here, the district court made factual findings following its *sua sponte* claim construction that would have been disputed by additional affidavit testimony addressing that construction had petitioner been given prior notice thereof, the circuits are split whether their district courts nonetheless retain discretion to enter summary judgment.

[10] *Ware v. Trailer Mart, Inc.*, 623 F.2d 1150 (6th Cir. 1980); 10A Wright and Miller, Federal Practice and Procedure, Civil § 2725. More recently, in *Bennett v. City of Eastpointe*, 410 F.3d 810, 816 (6th Cir. 2005), the Sixth Circuit expressly applied a standard of review, apart from the *de novo* review of summary judgment, of a abuse of discretion for its *sua sponte* entry. *Accord, Brown v. Raymond Corp.*, 423 F.3d 640, 648-49 (6th Cir. 2005).

when they intend to rely on grounds other than those briefed and argued by the litigants. *Id.*[11]

In *Colvin, supra*, the Federal Circuit similarly treated as discretionary the district court's obligation to insure that proper notice is given prior to entry of summary judgment. While noting this Court's plain statement of the rule in *Celotex*: "[t]he Supreme Court has stated that 'district courts are widely acknowledged to possess the power to enter summary judgments *sua sponte*, so long as the losing party was on notice that she had to come forward with all of her evidence' [citation omitted]," the court remanded only because it found it "difficult to review" the case without the benefit of the parties' arguments on the dispositive issue, "difficult to determine" whether factual issues remained to be resolved, and found remand to be the most "efficient" disposition of the case.

After petitioner's appeal was decided, the Federal Circuit addressed this issue in a published opinion.[12] In *Rothe Dev't Corp. v. DOD*, 413 F.3d 1327, 1336-37 (Fed. Cir. 2005), the

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[11] A separate ground for reversing the summary judgment in *Weiss* was that discovery had been stayed pending the disposition of the issues raised in Reebok's motion. 91 Fed. Appx. at 690.

[12] In *Nat'l Presto Indus, Inc. v. West Bend Co.*, 76 F.3d 1185, 1188 (1996), the court treated the related issue of granting summary judgment in favor of the non-movant on the grounds raised in its adversary's motion. That situation does not implicate the scope of the burden placed on the non-movant to meet the points raised by his adversary. Rather, it addresses the fairness of granting summary judgment against the party who asked for it on a claim (patent invalidity) upon which the moving party had the burden of proof.

court again treated the notice requirement of *Celotex* as a mere admonition of caution, entitling it to consider in equity "several factors that weigh against remand," rather than as a clearly defined mandate.[13]

But this is not always the case. In *Bemis*, *supra*, the court remanded because the district court had granted summary judgment of non-infringement without prior notice of its grounds, the plaintiff patentee having moved for summary judgment of infringement, and the defendant having moved only for summary judgment of invalidity. The Federal Circuit followed its established rule that, on issues that are not unique to its exclusive jurisdiction, it will follow the rule of the regional circuit in which the district court whose judgment is being appealed lies. *Id.* at 935 ("But in the Seventh Circuit, before such a summary judgment can be granted, certain procedural due process requirements must be met."), citing *Simpson v. Merchants Recovery Bureau, Inc.*, 171 F.3d 546, 549 (7th Cir.1999) ("a district court *lacks the power* to grant summary judgment" without proper notice.) (emphasis added).[14]

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[13] Petitioner was not benefitted with an opinion identifying the factors weighed by the Federal Circuit in failing to apply the mandate of Rule 56 as recognized by this Court in *Celotex*.

[14] The Federal Circuit also followed the rule of the Seventh in *Glaverbel Societe Anonyme v. Northlake Marketing & Supply, Inc.*, 45 F.3d 1550, 1560 n.3 (Fed. Cir. 1995), relying upon *Edwards v. Honeywell, Inc.*, 960 F.2d 674, 674 (7th Cir. 1992) ("a district court *cannot* grant summary judgment on a ground to which the nonmovant was given 'either an inadequate opportunity or no opportunity to respond'") (emphasis added), in remanding a summary judgment that none of defendant's formulations infringed plaintiff's patent, after defendant moved for partial summary

In *Massey v. Del Labs., Inc.*, 118 F.3d 1568 (Fed. Cir. 1997), the court remanded under circumstances quite similar to those in *Bemis, supra*. The court again relied upon the mandatory nature of the rule, this time as applied in the Ninth Circuit (*id.* at 1572), citing *Waterbury v. T.G.&Y. Stores Co., Inc.*, 820 F.2d 1479 (9th Cir. 1987) ("a district court *may not* grant summary judgment *sua sponte* without proper notice.) (emphasis added).[15] At least the Third Circuit is in agreement. *Otis Elevator Co. v. George Washington Hotel Corp.*, 27 F.3d 903, 910 (3d. Cir. 1994).

Moreover, the Federal Circuit is uniquely susceptible to conflicts among the regional circuits regarding procedural issues, as it endeavors to apply the rule of the regional circuit in which the district court whose judgment is being appealed lies, in resolving issues not unique to its exclusive jurisdiction.[16] *See, Bemis, supra*, 21 Fed. Appx. at 935.[17]

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judgment that only some of its formulations did not infringe. *Glaverbel* at 1561-62.

[15] The frequency, demonstrated here, with which the courts enter summary judgment *sua sponte* or without proper notice against individual patent owners, such as petitioner, may reflect the general bias or incredulity directed toward them or other non-commercial patentees that seems to be inherent in the policy issues raised in *eBay, Inc. v. MercExchange, LLC*, No. 05-130, recently argued before this Court.

[16] In the Second Circuit, where the district court from which petitioner appealed lies, the grant of summary judgment *sua sponte* or without adequate notice is deemed to be discretionary. *Bridgeway Corp. v. Citibank*, 201 F.3d 134 (2d Cir. 2000) ("While it is not necessarily reversible error in our Circuit for a district court to grant summary judgment against the moving party without notice or opportunity to defend,... we have firmly discouraged the

While this may foster the policy against forum shopping inherent in the 1982 formation of the Federal Circuit, and permit the uniform treatment of such procedural issues in the district courts of the regional circuit regardless of the court having appellate jurisdiction of the case, it results in the inconsistent, unfair application of dispositive procedural rules among parties seeking relief under the exclusive jurisdiction of the court, *e.g.*, in patent infringement cases. The only way to resolve this tension is for this Court to eliminate the conflicts among the circuits on such important dispositive procedural questions, implicating constitutional rights, as are raised in this petition.[18]

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practice.")

[17] *Cf., Rothe, supra,* 415 F.3d at 1336-37, and *Weiss, supra,* 91 Fed. Appx. at 689-90, where, as in petitioner's case, the court gave no indication that it was applying the rule of the originating regional circuit on this issue.

[18] Because the Federal Circuit often treats the prohibition of summary judgment *sua sponte* or on grounds not raised in a motion as discretionary, rather than mandatory, it is often unclear what scope the court affords the substantive rule, if anything consistent, as it exercises discretion based in part upon the content of the notice, the grounds of the judgment, and the differences between them, the very things that generally delimit the rule.

2. The Federal Circuit Has Expressly Declined to Follow the Rule of the Eleventh Circuit Defining the Scope of the Burdens Placed by *Celotex* on the Parties and the Resulting Notice Required Before Granting Summary Judgment

Recently, the Federal Circuit in *Exigent Technology, Inc. v. Atrana Solutions, Inc.*, 05-1338, slip op. 2006 WL 708682 (Fed. Cir. Mar. 22, 2006), expressly declined to follow the Eleventh Circuit rule defining the burden that Rule 56(c) places upon the moving party:

> In *United States v. Four Parcels*, 941 F.2d 1428 (11th Cir. 1991) (en banc), the Eleventh Circuit stated: "Justice Rehnquist's opinion in *Celotex* does not explain exactly how the moving party may show the court that the nonmoving party will be unable to prove its case. In this Circuit, even after *Celotex*, it is never enough simply to state that the non-moving party cannot meet its burden at trial. [citations omitted] *Instead, the moving party must point to specific portions of the record in order to demonstrate that the nonmoving party cannot meet its burden of proof at trial.*" *Id.* at 1438 n.19 (internal citations omitted) (emphasis added).

2006 WL 708682 at *4-5. While the Federal Circuit did acknowledge a requirement of specificity, it expressly rejected the stricter rule, espoused by the Eleventh Circuit, which the Federal Circuit emphasized above:[19]

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[19] The Eleventh Circuit, in language not quoted by the Federal Circuit in *Exigent*, expounded on the rule that the Federal Circuit refused to follow and reconciled it with *Celotex*:

> While the Supreme Court in *Celotex* did not articulate, with precision, the minimum that a movant must do in its motion to discharge its burden, the Court did explain that "where the non-moving party will bear the burden of proof at trial on a dispositive issue . . . ," all that is required is "notice [to the party with the burden of proof] that she had to come forward with all of her evidence." [477 U.S.] at 326. In the light of *Celotex*, we conclude that nothing more is required than the filing of a summary judgment motion stating that the patentee had no evidence of infringement and pointing to the specific ways in which [the] accused systems did not meet the claim limitations. This is precisely what was done here.... *To the extent that the Eleventh Circuit has held that more is required, we do not follow it....*

> [White, J., concurring:] "It is not enough to move for summary judgment without supporting the motion in any way or with a conclusory assertion that the plaintiff has no evidence to prove his case." [citation omitted].... *Id.* at 325 [*sic.*, 324]: '[A] party seeking summary judgment always bears the initial responsibility ... *of identifying those portions* of the materials on file which demonstrate the absence of a genuine issue of material fact." (emphasis added by 11th Cir.)

Four Parcels, supra, 941 F.2d at 1428 n. 19.

Id. at *5 (emphasis added).[20] Thus, at least two circuits have failed to find sufficient guidance in *Celotex* on this issue; they cannot agree to the scope of the movant's burden on summary judgment nor, accordingly, the concomitant scope of the resulting evidentiary burden that shifts to the opposing party.

In rejecting the Eleventh Circuit rule, the Federal Circuit noted the "confusion among courts" acknowledged by the Eleventh Circuit regarding these burdens in *Fitzpatrick v. City of Atlanta*, 2 F.3d 1112, 1116 n.9 (11th Cir. 1993). *Exigent, supra* at *9 n.7. In *Fitzpatrick*, the court also addressed the burden that shifts to the non-movant, pursuant to Rule 56 and *Celotex*, once the movant meets its initial burden in moving for summary judgment: "[i]f ... the movant carries the initial summary judgment burden [by pointing out the absence of a genuine dispute], *responsibility then devolves upon the non-movant* to show the existence of a genuine issue *as to the material fact*" (emphasis added), citing FED.R.CIV.P. 56(e):

> When a motion for summary judgment is made *and supported as provided in this rule*, an adverse party may not rest upon the mere allegations or denials of

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[20] The record in petitioner's case reflects that the district court did not meet the standard expressed by the Federal Circuit in *Exigent*. The district court neither identified the claim limitation it would deem absent from the defendants' devices, nor pointed to the specific ways in which the accused devices might not meet that limitation, prior to its *sua sponte* grant of summary judgment on grounds other than those raised in Bauer's motion. The Federal Circuit then offered no explanation for failing to remand the case pursuant to *Celotex*, whether a perceived discretion not to remand, or a determination that Bauer's summary judgment motion shifted to petitioner a burden to come forward with all his evidence, not limited to the points raised in the motion.

> the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial.

2 F.3d at 1116 n.3 (emphasis added). By expressly rejecting the burden placed by the Eleventh Circuit upon a party moving for summary judgment to specify the grounds for its motion, the Federal Circuit necessarily rejected the views of the Eleventh Circuit as to the specificity of prior notice required and the resulting scope of the evidentiary burden that then shifts to the non-movant. That much appears from the judgment in petitioner's case.

3. The Circuits Are Split Regarding the Scope of the Required Notice and Resulting Evidentiary Burden Placed Upon the Party Opposing Summary Judgment

Other circuits, whether they treat the rule prohibiting summary judgment without notice as discretionary or mandatory, define the scope of the burden, placed by the motion or *sua sponte* notice upon the opposing party, incompatibly broadly or narrowly.

In the Sixth Circuit, which the Federal Circuit has followed in construing the rule as discretionary, the notice requirements of *Celotex* are otherwise applied literally. *See, Saxe v. Dlusky*, No. 04-4269, slip op., 2006 WL 27275 at *2 (6th Cir. Jan. 6, 2006) (reversing summary judgment entered on grounds other than upon which Dlusky's motion was based, the court found lacking "notice of the basis for the district court's *sua sponte* grant of summary judgment and thus of [Saxe's] need to come forward with all her evidence."); *Bennett, supra*, 410 F.3d at 817 (in action under

42 U.S.C. § 1983, while the Fourth Amendment was addressed on the motions, the defending party did not have sufficient notice of the 14th Amendment grounds for the judgment). *See also, Brown, supra*, 423 F.3d at 649, in which the court upheld summary judgment *sua sponte* on specific grounds of which the appellant had been given notice and an opportunity to submit evidence. The Sixth Circuit, therefore, places upon a party opposing summary judgment a narrow evidentiary burden, circumscribed by the specific issues raised in the motion or notice.

And in the Eighth Circuit, it is clear that, while the district court's request for an evidentiary showing may give notice that it is contemplating summary judgment on that issue, it does not constitute notice that the court might grant summary judgment on a different yet related issue. *See, Nunley v. DOJ*, 425 F.3d 1132, 1139 (8th Cir. 2005).

But in the Seventh Circuit, which the Federal Circuit has followed in construing the rule as mandatory, a party is deemed to have been placed on notice and required to come forward with all of his evidence where "similar" issues were fully briefed, and he could have "expected" the ground upon which summary judgment was based *sua sponte* would become an issue at trial. *Johnson v. Exxon Mobil Corp.*, 426 F.3d 887, 893 (7th Cir. 2005). Thus, the Seventh Circuit construes the opposing party's evidentiary burden broadly: it exceeds the scope of the issues raised by the movant or by notice of the court *sua sponte*.

A similar rule is applied in the Third Circuit. *See, Howard Johnson Int'l v. Cupola Enter. LLC,* 117 Fed. Appx. 820 (3d Cir. 2004) (treating a motion *in limine,* to preclude "in essence" all of defendants' evidence, a motion for summary judgment placing defendant on notice that it must

proffer all evidence supporting its defenses and counterclaims), citing *Otis Elevator, supra*.

In the Fifth Circuit, once a properly supported summary judgment motion is made raising specific points entitling the movant to judgment as a matter of law, the burden shifts to the non-movant having the ultimate burden of proof to come forward with evidence supporting all elements of his claims, whether or not addressed in its adversary's motion. *Celestine v. Petroleos de Venezuela SA*, 266 F.3d 345, 349 (5th Cir. 2001), citing *Fontenot v. Upjohn Co.*, 780 1190, 1194 (5th Cir. 1986). *Cf, Williams v. Midwest Employers Cas. Co.*, 34 Fed. Appx. 152 at *8 (5th Cir. 2002), in which the court, in this unpublished opinion, declined to follow that rule and instead, citing this Court's opinion in *Celotex*, remanded a summary judgment entered *sua sponte* on the issue of contractual compliance, where the only issues briefed related to the existence of the contractual duties.

The deprivation of petitioner's right to have a jury determine the factual issues of infringement, without an opportunity to meet his burden to overcome the district court's specific but previously undisclosed concerns that there may be no genuine dispute as to a material fact not raised in Bauer's motion and, thereby, circumventing the carefully worded safeguards of FED.R.CIV.P. 56, implicates a deprivation of his Seventh Amendment right to a jury trial, *see, Markman v. Westview Instr., Inc.*, 517 U.S. 370, 384-85 (1996); *Warner-Jenkinson, supra*, 520 U.S. at 37-39; *Winans v. Denmead*, 15 How. 330, 338 (1854), as well as his right to Due Process guaranteed by the Fifth Amendment. *See, Bemis, supra* at 935.

B. This Case Points Out the Importance of Construing an Operative Legal Instrument, in this Case the Claims of the Patent in Suit Pursuant to *Markman*, Prior to the Entry of Summary Judgment Based Upon the Court's *Sua Sponte* Construction

Even if the Federal Circuit had applied a strict notice rule in petitioner's case, holding that he had been placed on notice by Bauer's summary judgment motion on limited non-infringement grounds to marshal all of his evidence in full support of his infringement claims, including each literal claim element not made a basis for Bauer's motion, petitioner would not have known to submit evidence to rebut the ground upon which the district court ultimately granted summary judgment because he could not have anticipated the district court's claim construction.

In this case, the district court granted summary judgment that Bauer did not infringe petitioner's patent claims by construing the claims to require additional structure that is not recited in the claim, and that not even Bauer could imagine or anticipate for inclusion in its summary judgment motion.[21] The Federal Circuit recognized this predicament in *Weiss, supra*, in which it exercised discretion to remand:

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[21] The district court construed petitioner's patent claim to require separate garment material that does not also define the pockets of the garment (App. 33a-34a). The claim requires only a garment comprised of a body covering having pockets (elements 1-a, 1-b, *supra* page 5) that, in turn, holds the individual pads accurately in place (element 1-e). Because the district court *sua sponte* found no body covering material *separate* from that which defined the pockets therein, it found that there was *no remaining* body covering to hold the pads accurately in place (element 1-e).

> Because the district court ruled on a ground that had not been briefed by the parties, Dr. Weiss also clearly did not have an opportunity to give his proposed construction of the functional limitations of the patent claims. He should be given an opportunity to present his legal arguments if noninfringement is to hinge on such limitations, and the district court is the best forum in which to make them in the first instance. [91 Fed. Appx. at 690]

Surely, such predicament is not unique to patent law. A party opposing a motion for summary judgment that it failed to satisfy its own obligations as a prerequisite to its breach of contract claim would not be in a position to proffer evidence of its compliance with an obligation that the court read into the contract *sua sponte* in its decision. Nor would a party defending a motion for summary judgment that it did not comply with a statute, rule or regulation, be in a position to submit evidence of its compliance with a requirement not set out in the motion or apparent on the face of the written law. Absence of notice in such cases approaches a *per se* infraction of Rule 56.

In an effort to implement this Court's decision in *Markman v. Westview Instruments, supra*, the Federal Circuit has suggested that district courts issue an order, following a hearing if appropriate, in which the claims of a patent are to be construed, as a matter of law, prior to submitting the question of infringement to the fact finder. *See, Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448, 1463, 1480 (Fed. Cir. 1998) (*en banc*). Though the district courts already have at their disposal this suitable mechanism for resolving this problem in patent cases, the Federal Circuit apparently has assumed the discretion that it not be employed it in situations

such as petitioner's.[22] The wisdom of *Markman*, *Cybor*, and their progeny commands at least an order construing the operative document prior to granting summary judgment on a ground not raised by the parties and introduced by the court's *sua sponte* construction. Rule 56 then commands notice of the specific factual grounds upon which the district court will consider entry of summary judgment pursuant to its construction.

C. The Federal Circuit's Rules Permitting Judgments Affirming Without Opinion and Prohibiting Citation of Unpublished Decisions Should Be Addressed In View of the Recent Changes to the Federal Rules of Appellate Procedure

Federal Circuit Rule 36, in pertinent part, permits entry of judgment affirming the judgment of a district court where (a) the judgment of the trial court is based on findings that are not clearly erroneous, (c) the record supports summary judgment, or (e) a judgment or decision has been entered without an error of law.

None of those circumstances, however, provide a mechanism to address the entry of summary judgment *sua sponte* or without proper notice to the party against whom it was entered. The district court is not permitted to make

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[22] *See, Schoenhaus v. Gensco, Inc.*, 440 F.3d 1354, 1356 (Fed. Cir. 2006) ("... the district court granted defendants' motion for summary judgment of non-infringement. Senior Judge Louis H. Pollak did not issue a separate *Markman* order; rather, in a carefully-crafted summary judgment opinion, he construed two limitations of claim 1 of the patent and found as a matter of law that neither limitation was present in the accused shoes.")

findings of disputed facts; the record is not necessarily complete where the parties were not provided sufficient notice to complete the record on the issues to which summary judgment was ultimately directed; and the absence of an error of law does not implicate a review of the district court's *sua sponte* judgment for an abuse of discretion.

It is beyond pure speculation that the courts of appeals, in anticipation of the implementation of new F.R.A.P. 32.1, will be motivated to issue fewer opinions, the citation to which they will no longer be able to prohibit in their local rules. In so doing, the appellate courts will be more likely to favor judgments without opinion, liberally construing their rules such as FED.CIR.R. 36 or broadening their scope.

Given the potential impact of the new rule among the several circuits, this Court should address the scope and propriety of FED.CIR.R. 36 in relation to grants of summary judgment *sua sponte* and other judgments that require explanation yet may escape reconciliation with this Court's decisions and the circuits' published precedents.

CONCLUSION

It is respectfully submitted that this petition for a writ of certiorari reviewing the judgment of the United States Court of Appeals for the Federal Circuit be granted so that this Court can clarify the burdens created by FED.R.CIV.P. 56, consistent with its opinion in *Celotex v. Catrett*, and reconcile the conflicts among the courts of appeals on these important questions.

Respectfully submitted,

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APPENDIX A

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Nos. 05-1140/05-1176

[Filed January 24, 2006]

BERNARD F. DEPALMA,

Plaintiff-Appellant,

v.

NIKE, INC., CANSTAR SPORTS GROUP, INC. (now known as Bauer Nike Hockey, Inc.), and CANSTAR SPORTS USA (now known as Bauer Nike Hockey USA),

Defendants-Cross Appellants,

and SHERWOOD DROLET CORPORATION,

Defendant.

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on January 31, 2006.

APPENDIX B

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Nos. 05-1140/05-1176

[Filed December 6, 2005]

BERNARD F. DEPALMA,

Plaintiff-Appellant,

v.

NIKE, INC., CANSTAR SPORTS GROUP, INC. (now known as Bauer Nike Hockey, Inc.), and CANSTAR SPORTS USA (now known as Bauer Nike Hockey USA),

Defendants-Cross Appellants,

and SHERWOOD DROLET CORPORATION,

Defendant.

JUDGES: CLEVENGER, SCHALL, and BRYSON, Circuit Judges.

JUDGMENT

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

Per Curiam

AFFIRMED. See Fed. Cir. R. 36.

APPENDIX C

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK

No. 5:95-CV-1428

[Filed November 9, 2004]

Bernard F. DePalma,	)
	)
Plaintiff,	)
	)
v.	)
	)
Nike, Inc., an Oregon Corporation, CANSTAR SPORTS GROUP, INC., a Canadian corporation, CANSTAR SPORTS USA, a Vermont corporation, TROPSPORT ACQUISITIONS INC., a Canadian corporation, KARHU USA INC., a Vermont corporation, and SHERWOOD DROLET CORPORATION, a Canadian corporation,	)
	)
Defendants.	)
	)

JUDGMENT IN A CIVIL CASE

[x] Decision by Court. This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS ORDERED AND ADJUDGED; that judgment be entered in favor of the Defendants, in accordance with the Orders issued by U. S. District Judge Norman A. Mordue on July 5, 2001 and October 28, 2004.

November 9, 2004
DATE

LAWRENCE K. BAERMAN
CLERK OF COURT

/s/
DONNA M. FRANCISCO
DEPUTY CLERK

APPENDIX D

UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF NEW YORK

No. 5:95-CV-1428

[Filed October 28, 2004]

BERNARD F. DePALMA,

Plaintiff,

-v-

NIKE, INC., an Oregon Corporation, CANSTAR SPORTS GROUP, INC., a Canadian corporation, CANSTAR SPORTS USA, a Vermont corporation, TROPSPORT ACQUISITIONS INC., a Canadian corporation, KARHU USA INC., a Vermont corporation, and SHERWOOD DROLET CORPORATION, a Canadian corporation,

Defendants.

Norman A. Mordue, U.S. District Judge.

MEMORANDUM-DECISION AND ORDER

Plaintiff commenced this action on September 29, 1995, alleging infringement of United States Patent No. 4,507,801 ("801 patent") and seeking injunctive and monetary relief. Defendants interposed the affirmative defense that the 801 patent was invalid and a counterclaim seeking a declaration that the 801 patent was invalid. By Memorandum-Decision and Order dated July 5, 2001, this Court granted defendants' motion for summary judgment dismissing the complaint and denied their motion for summary judgment on the counterclaim. The Court ordered that the action would proceed upon the counterclaim and plaintiff's answer thereto.[1]

Plaintiff now moves pursuant to Fed. R. Civ. P. 12(h)(3) to dismiss the counterclaim, based on the fact that the patent expired on September 7, 2002. Plaintiff argues that there is no longer a need for a declaration regarding the validity of the patent and that therefore there is no longer an actual justiciable controversy such as would support a declaratory judgment.

In opposition, defendants contend that an actual case or controversy remains between the parties. Specifically, they argue that plaintiff "has indicated his intention to pursue infringement claims against them by appealing the summary judgment of noninfringement to the Federal Circuit."

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[1] On October 23, 2001, the Court denied plaintiff's motion for a "*sua sponte*" order of summary judgment dismissing the counterclaim or, in the alternative, for entry of judgment under Fed. R. Civ. P. 54(b) on so much of the July 5, 2001, order as dismissed the complaint, so as to permit an immediate appeal.

> The Declaratory Judgment Act, 28 U.S.C.A. § 2201, provides in subdivision (a):
>
> In a case of actual controversy within its jurisdiction, ... any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought. Any such declaration shall have the force and effect of a final judgment or decree and shall be reviewable as such.

Courts have "consistently interpreted this permissive language as a broad grant of discretion to district courts to refuse to exercise jurisdiction over a declaratory action that they would otherwise be empowered to hear." *Dow Jones & Co., Inc. v. Harrods Ltd.*, 346 F.3d 357, 359 (2d Cir. 2003). Factors which guide district courts' exercise of this discretion include whether the judgment will serve a useful purpose in clarifying or settling the legal issues involved; whether a judgment would finalize the controversy and offer relief from uncertainty; whether dismissal would prevent "procedural fencing"; and whether the question to be decided is of public importance. *See id.*, 10 C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE: CIVIL § 2759 (1973).

> The importance of declaratory judgment in patent cases is explained as follows:
>
> Certainly one of the most common and indisputably appropriate uses of the declaratory judgment procedure is to enable one who has been charged with patent infringement to secure a binding determination of whether proposed conduct will infringe a patent in

> question without waiting until he becomes the defendant in an actual infringement suit. The purpose of granting declaratory relief to one potentially liable for infringement is to allow him to know in advance whether he may legally pursue a particular course of conduct. The commercial or manufacturing activity he proposes may be of substantial benefit to society, yet it may have to be abandoned if it must be carried out at the risk of liability for patent infringement. Indeed, it was part of the purpose of the Declaratory Judgment Act to prevent patent owners from suppressing competition by threatening infringement without ever actually bringing the suits that would put their patents to the test.

Hanes Corp. v. Millard, 174 U.S. App. D.C. 253, 531 F.2d 585, 592 (Fed. Cir. 1976) (citation omitted).

The Federal Circuit has stated a two-part test for determining the justiciability of a claim to declare a patent invalid: there must be both "(1) an explicit threat or other action by the patentee, which creates a reasonable apprehension on the part of the declaratory plaintiff that it will face an infringement suit, and (2) present activity which could constitute infringement or concrete steps taken with the intent to conduct such activity." *BP Chemicals Ltd. v. Union Carbide Corp.,* 4 F.3d 975, 978 (Fed.Cir. 1993). The purpose of this two-part test is "to determine whether the need for judicial attention is real and immediate, or is prospective and uncertain of occurrence." *Id.* (citation omitted).

In the case at bar, the existence of plaintiff's action for infringement of the 801 patent obviously met the first prong of the *BP Chemicals* test. Moreover, defendants were engaged in activity which could constitute infringement of the patent so

long as the patent was viable. During the life of the patent, adjudication of defendants' counterclaim of patent invalidity would have enabled defendants to make decisions regarding future activity without uncertainty concerning the legality of their conduct or their exposure to liability for future damages. *See Hanes,* 531 F.3d at 592. Accordingly, during the life of the patent, the need for judicial attention was real and immediate within the meaning of *BP Chemicals*.

Now that the 801 patent has expired, however, there is no present activity on the part of defendants which could constitute infringement. Defendants have no need for a declaration regarding the validity of the patent to enable them to make decisions regarding future activity. Any infringement of the 801 patent has already occurred; any damages have already accrued. *See id.; Channel Master Corp. v JFD Electronics Corp.,* 263 F. Supp. 7 (E.D.N.Y. 1967). Moreover, inasmuch as this Court has dismissed the complaint, defendants can have no reasonable apprehension of facing an infringement suit. Of course, if plaintiff wins on appeal and proceeds to prosecute his infringement complaint, defendants would be entitled to pursue their claim of invalidity. As the case now stands, however, plaintiff has no viable claim for past or future infringement; thus, defendants can gain no possible benefit from a declaration of invalidity. There is no "real and immediate" need for judicial attention to the question of invalidity of the 801 patent.

Accordingly, the Court in its discretion declines to exercise jurisdiction over defendants' declaratory counterclaim. It is therefore

ORDERED that plaintiff's motion is granted; and it is further

ORDERED that the counterclaim is dismissed.

IT IS SO ORDERED.
October 28, 2004
Syracuse, New York

/s/
Norman A. Mordue
U.S. District Judge

APPENDIX E

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK

No. 95-CV-1428

[Filed July 5, 2001]

BERNARD F. DePALMA,
Plaintiff,

-v-

NIKE, INC., an Oregon Corporation, CANSTAR SPORTS GROUP, INC., a Canadian corporation, CANSTAR SPORTS USA, a Vermont corporation, TROPSPORT ACQUISITIONS INC., a Canadian corporation, KARHU USA INC., a Vermont corporation, and SHERWOOD DROLET CORPORATION, a Canadian corporation,
Defendants.

Hon. Norman A. Mordue, D.J.:

MEMORANDUM-DECISION AND ORDER

INTRODUCTION

In this patent infringement action, defendants Canstar Sports Group Inc. and Canstar Sports USA (now Bauer Nike Hockey Inc. and Bauer Nike Hockey USA, formerly Bauer Inc. and Bauer USA)[1] (collectively referred to herein as "Bauer defendants") move for summary judgment on the grounds that their products do not infringe plaintiff's patent and that, in any event, plaintiff's patent is invalid. They further move to limit damages based on plaintiff's alleged noncompliance with statutory marking and notice requirements; plaintiff cross moves for leave to serve a second amended complaint to plead compliance.

BACKGROUND

In this action, commenced September 29, 1995, under United States Patent Law, 35 U.S.C. § 271 *et seq.*, plaintiff claims that he owns the entire right, title and interest to U.S. Patent 4,507,801 ("801 patent"), entitled "Protective Garment," issued April 2, 1985. The "Abstract" portion of the 801 patent describes the invention as a "light, conforming protective garment for athletes made of a stretch material with pockets over the areas to be protected. Pads are formed to fit the wearer, inserted into the pockets, and are held closely in place by the stretch material." Plaintiff asserts that defendants have infringed the 801 patent by manufacturing, using and/or selling protective garments in violation of one or more patent claims, that they have induced others to infringe the patent, and that they have contributorily infringed the patent.

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[1] Defendant Nike, Inc. asserts that it is the parent of the Bauer defendants and therefore is not subject to liability in this action.

35 U.S.C. § 271(a), (b), (c).[2] Plaintiff claims that the infringements have been willful and deliberate, have caused him damages, and have resulted in profits to defendants. He seeks injunctive relief, a finding that defendants infringed the 801 patent, an accounting for profits and damages caused by the infringement, an award of money damages and increased money damages under 35 U.S.C. § 284, and attorneys fees based on a finding of exceptional circumstances under 35 U.S.C. § 285.

Plaintiff's First Amended Complaint, filed May 31, 1996, removed several defendants and added one. On May 6, 1999, the Court signed a stipulated dismissal of the action as to defendants Tropsport Acquisitions, Inc. (formerly known as Karhu Canada, Inc.) and Karhu USA, Inc. (later known as

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[2] 35 U.S.C. § 271 provides in part

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

SHC Hockey, Inc.). Sherwood Drolet Corp. has not appeared.

In their answer to the First Amended Complaint, the Bauer defendants interposed a counterclaim for judgment declaring that the 801 patent is invalid.

The Bauer defendants move for summary judgment on the grounds that their products do not infringe the 801 patent and that the 801 patent is invalid. They also seek a ruling that plaintiff's failure to comply with the marking and notice requirements of 35 U.S.C. § 287(a) bars recovery of pre-action damages.

Plaintiff cross moves for leave to serve a second amended complaint to plead compliance with 35 U.S.C. § 287(a).

APPLICABLE LAW

Summary judgment

"Summary judgment is as appropriate in a patent case as it is in any other case." *C.R. Bard, Inc. v. Advanced Cardiovascular, Inc.*, 911 F.2d 670, 672 (Fed. Cir.1990). A party seeking summary judgment must demonstrate that "there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). The nonmoving party may defeat summary judgment by producing sufficient evidence to establish a genuine issue of material fact for trial. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). The test for the existence of a genuine issue of material fact is whether a reasonable juror could find for the nonmoving party. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). In ruling on the motion, the court must resolve all ambiguities and draw all

reasonable inferences in favor of the nonmoving party. *See C.R. Bard,* 911 F.2d at 672.

Patents

Generally

Under the Constitution, Congress has the power to promote the progress of the useful arts by securing to inventors the exclusive right to their discoveries for limited times. *See* U.S. CONST, Art. I, § 8, cl. 8. In 1952, in the exercise of this power, Congress enacted the system in effect today, under which the Patent and Trademark Office reviews applications and issues patents. 35 U.S.C. §§ 1, *et seq.* "The primary purpose of our patent system is not reward of the individual but the advancement of the arts and sciences. Its inducement is directed to disclosure of advances in knowledge which will be beneficial to society; it is not a certificate of merit, but an incentive to disclosure." *Sinclair & Carroll Co. v. Interchemical Corp.,* 325 U.S. 327, 330-31 (1945).

Specification

An applicant for a patent must submit a specification, drawing (if appropriate), fee and oath. *See* 35 U.S.C. § 111. The specification must meet certain requirements:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly

> connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112.

Claims

Section 112 further provides: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The purpose of the claims is "to point out what the invention is in such a way as to distinguish it from what was previously known, i.e., from the prior art; and ... to define the scope of protection afforded by the patent." *In re Vamco Machine and Tool, Inc.*, 752 F.2d 1564, 1577, n. 5 (Fed. Cir. 1985). Thus, "claims are not technical descriptions of the disclosed inventions but are legal documents like the descriptions of lands by metes and bounds in a deed which define the area conveyed but do not describe the land." *Id.*

DISCUSSION

I. PATENT INFRINGEMENT

Generally

Analysis of a patent infringement complaint involves two inquiries: "determination of the scope of the claims, if there is a dispute as to claim interpretation or construction; followed by determination of whether properly interpreted claims encompass the accused structure." *Mannesmann Demag Corp. v. Engineered Metal Prods. Co., Inc.*, 793 F.2d 1279, 1282 (Fed. Cir. 1986). Even where a product does not infringe a

patent literally, infringement may be found under the doctrine of equivalents, which prevents an infringer from avoiding the patent by making an insubstantial change in the product. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1996). Under the "all elements" rule, there can be no infringement if even one element of a claim or its equivalent is not present in the accused device. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 587 (Fed. Cir. 2000). Thus, the basic inquiry is: "Does the accused product ... contain elements identical or equivalent to each claimed element of the patented invention?" *Id.*

Claim interpretation

Construction of the claims in a patent is a question of law for the court. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd* 517 U.S. 370 (1996). In interpreting claims, the court looks first to the intrinsic evidence, *i.e.*, the patent itself, comprising the claims, the specification and, if in evidence, the prosecution history. *See id.*, 52 F.3d at 979. The specification is "the single best guide to the meaning of a disputed [claim] term." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). The prosecution history of the patent, which contains the complete record of the proceedings before the Patent and Trademark Office, including any representations made by the applicant regarding the scope of the claims, is also of great significance in construing the claims. *See id.* at 1582-83; *Markman*, 52 F.3d at 980.

When analysis of the intrinsic evidence alone resolves any ambiguity in a disputed claim term, it is improper to resort to

extrinsic evidence.[3] *See Vitronics,* 90 F.3d at 1583. Only when there is still some genuine ambiguity in the claims, after consideration of all available intrinsic evidence, or when necessary to aid the court in understanding the meaning or scope of technical terms in the claims, should the court consider extrinsic evidence, such as expert testimony, inventor testimony, and technical treatises and articles, in order to understand the technology and construe the claims. *See id.* at 1583-84. The court may not, however, rely on such evidence to vary or contradict the claim terms. *See id.* at 1583, *Markman,* 52 F.3d at 980-81.

Literal infringement

Literal infringement occurs when the accused device embodies every element of the patent claim, *i.e.,* when "the properly construed claim reads on the accused device exactly." *Amhil Enters., Ltd. v. Wawa, Inc.,* 81 F.3d 1554, 1562 (Fed. Cir. 1996).

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[3] The public is entitled to rely on the public record of the patent, that is, the claims, specification, and file history. "[C]ompetitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention." *Vitronics Corp. v. Conceptronic, Inc.,* 90 F.3d 1576, 1583 (Fed. Cir. 1996), *citing Markman v. Westview Instruments, Inc.,* 52 F.3d 967, 978-79 (Fed. Cir. 1995), *aff'd* 517 U.S. 370, 387-88 (1996). Allowing the public record to be altered or changed by extrinsic evidence introduced at trial, such as expert testimony, would make this right meaningless. *See Vitronics,* 90 F.3d at 1583.

Infringement Under the Doctrine of Equivalents

The essence of the doctrine of equivalents is that "one may not practice a fraud on a patent." *Grever Tank & Mfg. Co. v Linde Air Prods. Co.,* 339 U.S. 605, 608 (1950). Infringement under this doctrine occurs when the accused product "performs substantially the same function in substantially the same way to obtain the same result" as the patented invention, *Id.* The doctrine of equivalents may not properly be applied to extend the reach of a patent to capture prior art; "no one deserves an exclusive right to technology already in the public domain." *Marquip, Inc. v. Fosber Am., Inc.,* 198 F.3d 1363, 1367 (Fed. Cir. 1999). Also, the range of equivalents may be limited by prosecution history because "a patentee cannot recapture subject matter surrendered during the prosecution of the patent. Estoppel may arise by amendments made to overcome prior art rejections, or by argument made to secure allowance of a claim." *Lockheed Martin Corp. v. Space Systems/Loral, Inc.,* 2001 WL 436028, * 10 (Fed. Cir. 2001) (citation omitted).

The doctrine must be applied independently to each limitation of the claim, *see Stryker Corp. v. Davol, Inc.,* 234 F.3d 1252, 1257 (Fed. Cir. 2000), and, due to factors such as prosecution history estoppel, *see Festo,* 234 F.3d at 564, or the inherent narrowness of the claim language, *see, e.g., Sage Prods., Inc. v. Devon Inds., Inc.,* 126 F.3d 1420, 1425 (Fed. Cir. 1997), many claim limitations warrant a narrow range of equivalents, or none at all. As noted, there can be no infringement if even one element of a claim or its equivalent is not present in the accused device. *See Festo,* 234 F.3d at 587. "The doctrine of equivalents is not a talisman that entitles a patentee to a jury trial on the basis of suspicion; it is a limited remedy available in special circumstances, the evidence for which is the responsibility of the proponent."

Schoell v. Regal Marine Indus., Inc., 247 F.3d 1202, 1210 (Fed. Cir. 2001).

Infringement - summary judgment

As noted, claim construction is a legal matter for the court. Infringement, both literal and under the doctrine of equivalents, is a question of fact. *See Desper Prods. v Qsound Labs., Inc.*, 157 F.3d 1325, 1332-33 (Fed. Cir. 1998). Where the composition of the accused product is undisputed, the issue of literal infringement collapses into claim construction, a question of law amenable to summary judgment. *See id.* Likewise, "[a]lthough equivalence is a factual matter normally reserved for a fact-finder, the trial court should grant summary judgment in any case where no reasonable fact-finder could find equivalence." *See Sage Prods.*, 126 F.3d at 1423. Thus, summary judgment on the issue of infringement is appropriate where no reasonable jury could find infringement, either literal or by equivalents, on the undisputed facts or when all reasonable factual inferences are drawn in favor of plaintiff. *See* Fed. R. Civ. P. 56(c); *Schoell,* 247 F.3d at 1210. Because plaintiff bears the burden of proving infringement at trial, to avoid summary judgment he must adduce evidence that the accused product contains elements identical or equivalent to each limitation, *Id.*

The Motion

The 801 claim

The claim states in full:

1. A protective garment for protecting at least the upper part of the body of an athlete comprising:

a. tightly fitting body-covering means made of stretchable material;
b. plurality of pockets affixed to the body covering means;
c. said pockets being located in the portion of the body-means covering the body portion to be protected;
d. a plurality of impact-absorbing pad means for protecting a body portion adapted to fit in the pocket means covering the body portion to be protected;
e. each pad means being shaped to conform to the contours of the wearer's body at the portion to be protected, whereby the pad means, fitting into the pocket means, protects a portion of the body by closely conforming to the body, held accurately in place by stretching of body covering means;
f. the garment having pocket means and pad means for insertion therein to cover and protect at least the acromio-clavicular joint of the shoulder;
g. said pocket means and pad means protecting the said acromio-clavicular joint of the shoulder extending downward to the wearer's pectoral and upper trapezius muscles, such that the pad means is bridged over the acromio-clavicular joint of the shoulder, leaving a gap between the top of the wearer's shoulder and the pad means, whereby impact forces are transferred to the pectoral and trapezius muscles, while allowing free movement of the shoulder.

2. The protective garment of claim 1 in which the pad means is made at least in part of material which may be formed while at a temperature higher than normal, and which retains the shape while at normal

temperature, whereby the pad means may be molded to each wearer's body shape.

3. The protective garment of claim 2 in which the pad means comprise a rigid center layer of heat formable material covered with a plurality of layers of closed cell foam material.

4. The protective garment of claim 3 in which the rigid center layer is polycarbonate plastic.

5. The protective garment of claim 3 in which the rigid center layer is rigid polyethylene plastic.

6. The protective garment of claim 3 in which the closed cell foam material is heat moldable closed cell polyethylene foam plastic.

7. The protective garment of claim 1 further comprising pocket means and pad means located to protect the deltoid area.

8. The protective garment of claim 1 further comprising pocket means and pad means located to protect at least part of the rib area.

9. The protective garment of claim 1 further comprising pocket means and pad means located to protect at least part of the humerus area.

Prosecution history

The patent examiner rejected the application[4] twice before granting the 801 patent. The invention as originally defined (now found in Claim l(a) through (e)) was a "tightly fitting body-covering means made of stretchable material" with a "plurality of pockets ... located in the portion of the body-means coveting the body portion to be protected," with a "plurality of impact-absorbing pad[s]" which are "adapted to fit in the pocket[s]" and are "shaped to conform to the contours of the wearer's body at the portion to be protected" such that the pads, when fitted in the pockets, "protect[] a portion of the body by closely conforming to the body, held accurately in place by stretching of body covering means."

The examiner rejected the first and second applications primarily on the ground that the invention was clearly anticipated by, and obvious in view of, a patent owned by John Livernois (U.S. Patent 4,325,148). The Livernois invention, a protective garment for ice hockey players, is a stretch garment for the lower body containing pockets for the insertion of protective pads located over the areas of the lower body to be protected. To eliminate this ground for rejection, the applicants added to claim one the following two dependent claims: "the garment having pocket means and pad means for insertion therein to cover and protect at least the acromio-clavicular joint of the shoulder," (Claim l(f)), and "said pocket means and pad means protecting the said acromio-clavicular joint of the shoulder extending downward to the wearer's pectoral and upper trapezius muscles, such that the

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[4] The applicants for the 801 patent were Frank J. Kavanaugh, James D. Plunkett, and plaintiff. Kavanaugh and Plunkett subsequently assigned their interests to plaintiff.

pad means is bridged over the acromio-clavicular joint of the shoulder, leaving a gap between the top of the wearer's shoulder and the pad means, whereby impact forces are transferred to the pectoral and trapezius muscles, while allowing free movement of the shoulder." (Claim 1 (g).)

In support of the application, the applicants contended that the novelty of their invention "lies in the recognition that the use of stretch material holding pads in pockets firmly against the body of the user will provide novel protection for the shoulder and upper body, because the pads will not shift position relative to the body of the wearer." They distinguished the prior art Cooper upper body protection (including Cooper XL3ML and Cooper SB96, samples of which have been submitted to this Court) on the ground that the Cooper pads are conventional football style shoulder pads, with "no stretch garment, the pads do not conform to the body, and they are free to move and shift about the player's body as are all of the prior art shoulder pads." They also pointed out that the shifting of conventional shoulder pads presents a serious problem due to the nature of the acromio-clavicular ("A-C") joint, which requires greater protection and more flexibility than the muscles and joints of the lower body, requirements which are not addressed by the Livernois lower body protection.

Further, the applicants contended that "they were the first to conceive and reduce to practice a garment having pocket means and pad means for insertion therein to cover at least the acromio-clavicular joint of the shoulder." In distinguishing Patent 3,504,377 issued to E.R. Biggs, Jr., which teaches pads resting on the chest and back of the wearer and maintaining a U-shape bridging the A-C joint by means of a reverse curve, they emphasized that in the Biggs invention "the pad is not held in position by a pocket in stretch material

so as to maintain a space between the top of [the athlete's] shoulder and the pad [.]"

The applicants further relied on the affidavits of two experts, Drs. Daniel I. Yale and Russell R. Zelko, both of whom stated that prior to the applicants' invention, it was not obvious "that protection could be maximized with a pad over [the A-C] joint, held in place even during movement of the joint by stretch material, while at the same time allowing movement of the joint." Drs. Yale and Zelko further asserted that as a result of applicants' invention, "a major step had been made providing protection to the athlete, which had not been obvious from using pads in pockets of stretch material in the lower part of the body." Based on these submissions, the examiner granted the 801 patent.

Pads

The Bauer defendants argue that the 801 patent is limited to pads which are custom-molded to the individual wearer by heating the pads. Claim one refers to pads which are shaped "to conform to the contours of the wearer's body," which the Court interprets to mean pre-shaped in the manufacturing process to fit a typical athlete's upper body. Indeed, claim two expressly encompasses the protective garment of claim one, but adds the element of a pad which "may be molded to each wearer's body shape" (emphasis added) by being made of material "which may be formed while at a temperature higher than normal, and which retains the shape while at normal temperature[.]" Moreover, in the specifications, the only reference to custom-molded pads is found in the section headed, "Description of the Preferred Embodiment," and reads as follows:

> A pad of impact-absorbing material is fitted into each pocket .... We have found that the best materials for this application are those which can be custom-molded at relatively low heat.... An ideal material, at least in part, is a closed-cell polyethylene foam plastic such as BXL Plastazote TM, a... foam which may be cut to shape, heated in an ordinary oven ... and then molded to the wearer. When cool, it will retain its shape. The pads may be inserted into and removed from the pockets easily. Thus, washing both the garment and the pads is made a simple matter.

It is clear from this portion of the specifications and from the discussion in the specifications of other types of foam which could be used, that custom-molding is just one method of achieving the conforming shape of the pads. Nothing in the prosecution history supports a contrary interpretation. Therefore, a reading of claim one alone and in light of claim two and the specifications establishes that claim one is not limited to a pad which is molded to the individual wearer when heated.

Pockets

Claim one states that the pockets are to be "affixed" to the garment, that the pads are to be "adapted to fit in the pocket means," and that the garment has "pocket means and pad means for insertion therein to cover and protect" at least the A-C joint. The Bauer defendants contend that the 801 patent thus covers only garments with pockets with openings which permit the athlete to insert and remove the pads. They rely on the dictionary definition of "pocket" as "a small bag that is sewed or inserted in a garment so that it is open at the top or side." *Webster's Collegiate Dictionary,* 10th Ed. (1998). In opposition, plaintiff argues that within the field of athletic

clothing and equipment the term has a specialized use as an enclosure, which may be open or closed, formed by sewing one piece of fabric onto another, and in which a component of the equipment is secured. Plaintiff points to the alternative definition of the word pocket in Webster's Dictionary as "a cavity containing a deposit (as of gold, water, or gas)"; such a cavity does not necessarily have an opening.

The Court reads the word pocket in claim one of the 801 patent as describing an enclosure created by sewing a piece of fabric to the garment, for the purpose of holding a pad in place on the garment. This purpose may be accomplished by open or closed pockets. The claims do not specify that the pads must be removable, by way of an opening in the pocket or other means. Nor do the claims exclude garments with pads inserted by the manufacturer during the manufacturing process by placing them into pockets which are then sewn shut.[5] There is nothing in the prosecution history which casts doubt on this conclusion.

In the specifications, the only reference to removal of the pads is found in the "Description of the Preferred Embodiment," referring to custom-molded pads, discussed above. If the pad is to be heated in the oven and molded to the individual wearer, it is logical that there must be a method for removal and insertion of the pad by the wearer. As the Court

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[5] The use in claim one of the word "insertion" does not support a contrary conclusion because it does not imply that the pocket must be amenable to repeated insertion and removal of the pad. The Court notes that the definition of the verb "insert" in Webster's Dictionary is: "1. to put or thrust in ... 2. to put or introduce into the body of something... 3. **to set in and make fast, *esp:* to insert by sewing between two cut edges** ..." (emphasis added).

has found above, custom-molded pads are a preferred embodiment, not a limitation on the claims. *See Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir.1998) (preferred embodiment of invention does not limit scope of claims). The Court finds that pockets with an opening are specified only insofar as they are necessary to accommodate insertion and removal of a custom-molded pad in a preferred embodiment, and do not constitute a claim limitation.

Body-covering means

The Court does not read the 801 patent as limited specifically to a "shirt or vest." As the Court reads the claims, specifications and prosecution history, the requirements regarding the form of the body-covering means, or garment, relate to its function, *i.e.*, it must be stretchy, tightly-fitting and cover the areas to be protected, such that the pads will be held firmly in place and will not shift. Thus, the 801 patent teaches a body-covering means for the upper body, which may resemble a shirt, vest, sweater, jacket, or any other form-fitted garment for the upper body, and which fits tightly to the wearer's body by virtue of its shape and its stretchy fabric.

Construction of 801 patent

Based on the public record, specifically the claims themselves, the specifications and the prosecution history, the Court concludes as follows. Claim one of the 801 patent[6]

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[6] Claim one is the only independent claim. Claims two through nine depend on claim one. The Court has considered them (particularly claim two) as aids in interpreting claim one.

teaches a tightly fitting garment for the upper body made of stretchable material. The garment fits tightly on the wearer's upper body by virtue of the shape of the garment and the stretchy quality of the material from which it is made. The garment has pockets sewn into it located over the areas of the upper body to be protected. Each pocket may have an opening or be sewn closed. The pockets contain protective pads,[7] which are held in place by being contained within the pockets on the tightly-fitting stretch garment. The pads are shaped to conform generally with the portion of the body to be protected; they need not be, but may be, custom-molded to conform to the body of the individual wearer. As a result of the placement of the conforming pads in the pockets in the tightly-fitting stretch garment, the padding is held accurately in place on the wearer and will not shift. In other words, it is the combination of the tight fit of the garment, the stretchy material of which it is made, and the conforming shape of the pads which causes the pads in the pockets on the garment to be held firmly in place over the portions of the body of the wearer to be protected, such that they do not shift.

Claim one is further limited to a garment which protects at least one area, the A-C joint of the shoulder, by a pad which "bridges" over the A-C joint, leaving a gap between the top of the shoulder and the pad. The shoulder pad is held in place by its shape and its placement in the pocket in the tightly fitting stretch garment. Due to the location of the shoulder pad and its shape, impact forces are transferred to the pectoral and trapezius muscles, while allowing free movement of the shoulder.

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[7] The composition of the pads is not in issue here.

The accused products

The Court now turns to the second step of the infringement analysis, *i.e.*, determining whether, resolving all ambiguities and drawing all reasonable inferences in favor of plaintiff, plaintiff has adduced evidence that the accused products embody every limitation of the claim, either literally or by a substantial equivalent. The products which are the subject of this action[8] are Bauer Supreme SP 3000; Bauer Supreme SP 3000J; Bauer Vapor SP 4; Bauer Vapor SP 4J; Flak FSP Junior Pro Supreme; Flak FSP 100; Flak FSP 100 Junior Pro; Flak FSP 100 Pro Supreme; Flak FSP 175; Flak FSP 175C; Flak FSP 250; Flak FSP 275; Flak FSP 275C;

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[8] In their brief, the Bauer defendants argued that plaintiff could not establish infringement for certain accused shoulder pad models for which no samples could be located. These models were: Cooper CSB Pro Cooperall, Cooper CSB 2 Cooperall, Flak FSP 250, Flak FSP 300, Flak FSP 500 Air Armor, Flak FSP 300 Pro Supreme, Cooper Techniflex SP 400, Cooper Techniflex SP 700, and Cooper Techniflex SP 1000. When, after briefing and oral argument, the Court requested the parties to submit samples of the accused products, however, the parties either located samples for each model or were able to agree that the model was identical to a submitted sample in all material respects. If they had been unable to do so, the Court would have been compelled to grant summary judgment dismissing plaintiff's claim of infringement by these products, on the grounds that plaintiff did not seek court assistance to obtain samples of these models, did not demonstrate any ground to penalize the Bauer defendants for their inability to produce them, did not show any reason to excuse him from carrying his burden of proving infringement with respect to these models, and did not show that he could carry this burden in the absence of these samples.

Flak FSP 300 Pro Supreme; Flak FSP 300; Flak FSP 375; Flak FSP 375C; Flak FSP 500 Air Armor; Cooper CSB 1000 Cooperall; Cooper CSB 2000 Cooperall; Cooper CSB 3000 Cooperall; Cooper CSB 2 Cooperall; Cooper CSB Pro Cooperall; Cooper Techniflex SP 400 Jr.; Cooper Techniflex 500; Cooper Techniflex SP 700; Cooper Techniflex 750; Cooper Techniflex SP 900; Cooper Techniflex SP 1000; CSB Cooper Super Pro Cooperall; Cooper CSB 3 Cooperall; Velocity SP X 70; Velocity SP X 70J; Velocity SP X 90; Flak FSP 500C; and Supreme SP 5000 1997.

Bauer Supreme SP 3000; Bauer Supreme SP 3000J

Plaintiff has submitted a sample of the Bauer Supreme SP 3000. The parties agree for the purposes of this action that this product is the same as the Bauer Supreme SP 3000J. This product is a structure comprising fairly rigid front and back padding, made up of a number of smaller pads. These small pads are, separately or in groups, encased in stretch fabric and attached to other pads or groups of pads by stitching, velcro-like strips or elastic straps. Thus, the front and back structures are flexible at the places where the pads adjoin. The product is open at the sides so that the athlete pulls it on over his head, then fastens straps at the side, under the arms. To this structure are attached rigid cupped shoulder pads encased in stretch fabric, and fairly rigid upper-arm pads, likewise separately encased in stretch fabric. The shoulder pads and arm pads are attached to the main structure of the product by stitching a portion of the fabric encasing the shoulder and arm pads to a portion of the fabric encasing the main structure. The product is essentially made up of the pads themselves, encased in stretch fabric and joined closely together by various means. There is no discernable separate garment apart from the fabric-encased pads. Nor are the pads held against the body by the stretchiness and tight fit of the product;

rather, they are held in place by virtue of their incorporation into the shell-like structure of the product.

In contrast, the 801 claims teach a stretch garment, made to fit tightly on the upper body like a shirt or other typical garment for the upper body. Even when the pads are inserted, a significant portion of the garment is not padded, its function being to provide a tight fit on the wearer's body serving to hold the pads firmly in place over the portion of the body to be protected. The Court finds as a matter of law, resolving all ambiguities and drawing all reasonable inferences in favor of plaintiff, that the accused product does not read literally on Claim l(a) through (c) of the 801 patent because the accused product does not comprise a tightly fitting body-covering means for the upper body made of stretchable material, to which is affixed a plurality of pockets, into which are inserted pads which are held in place by the tight fit and stretchiness of the body covering means.

The Court further holds, resolving all ambiguities and drawing all reasonable inferences in favor of plaintiff, that no reasonable jury could determine that Claim l(a) through (c) is met in the accused product by an equivalent. First, plaintiff does not articulate the manner in which any element of the accused product performs substantially the same function as any limitation of the 801 invention, in substantially the same way, to obtain substantially the same result. Nor does it appear to the Court that it does so. The tightly fitting stretch garment which serves to hold the pads firmly in place over the areas to be protected performs the protective function in a distinct manner from the fairly rigid shell-like structure of the accused product. There is no basis on which a reasonable jury could find that the differences between the two are "insubstantial" to one of ordinary skill in the art.

Moreover, in addressing Cooper's protest to their first patent application, the applicants distinguished the prior art Cooper products on the ground that they contained no stretch garment. Plaintiff cannot now resort to the doctrine of equivalents to extend the reach of the patent to capture products which have no stretch garments. Thus, applying the "all elements" rule, which holds that there can be no infringement if even one limitation of a claim or its equivalent is not present in the accused device, the Court finds that there is no infringement.

Bauer Vapor SP 4; Bauer Vapor SP 4J

The Bauer Vapor SP 4 is virtually identical to the Bauer Supreme SP 3000 in every material respect. The arm pads are attached in a slightly different manner but this distinction is immaterial. The Court's discussion of the Bauer Supreme SP 3000 applies equally to this product. The parties agree for the purposes of this action that this product is the same as the Bauer Vapor SP 4J. The Court finds that there is no infringement by these products.

Flak FSP Junior Pro Supreme; Flak FSP 100; Flak FSP 100 Junior Pro; Flak FSP 100 Pro Supreme; Flak FSP 175; Flak FSP 175C; Flak FSP 250; Flak FSP 275; Flak FSP 275C; Flak FSP 300 Pro Supreme; Flak FSP 300; Flak FSP 375; Flak FSP 375C; Flak FSP 500 Air Armor; Flak FSP 500C.

The parties submit the following samples and agree for the purposes of this action that they are the same in all material respects: Flak FSP Junior Pro Supreme; Flak FSP 100; Flak FSP 275; Flak FSP 275C; Flak FSP 375; Flak FSP 300 Pro Supreme. They further agree for the purposes of this action that the following models, which have not been submitted to

the Court, are the same as these samples in all material respects: Flak FSP 100 Junior Pro; Flak FSP 100 Pro Supreme; Flak FSP 175; Flak FSP 175C; Flak FSP 250; Flak FSP 300; Flak FSP 375C; Flak FSP 500 Air Armor. A sample of Flak FSP 500C has also been submitted to the Court.

The submitted models, Flak FSP Junior Pro Supreme, Flak FSP 100, Flak FSP 275, Flak FSP 275C, Flak FSP 375, and Flak FSP 300 Pro Supreme are virtually identical to Bauer Supreme SP 3000 in every material respect. Flak FSP 500C is similar to Bauer Supreme SP 3000 except that it is much shorter, it is a more rigid structure, and it is covered in some areas by rigid plates. It does not infringe the 801 claims for the same reasons that Bauer Supreme SP 3000 does not. The Court's discussion of Bauer Supreme SP 3000 applies equally to these products. The Court finds that there is no infringement by these products.

Cooper Techniflex SP 400 Jr.; Cooper Techniflex 500; Cooper Techniflex SP 700; Cooper Techniflex 750; CooperTechniflex SP 900; Cooper Techniflex SP 1000

The parties submit the following samples and agree that for the purposes of this action they are the same in all material respects: Cooper Techniflex SP 400 Jr.; Cooper Techniflex SP 700; Cooper Techniflex 750; Cooper Techniflex SP 900. They further agree for the purposes of this action that the following models, which have not been submitted to the Court, are the same as these samples in all material respects: Cooper Techniflex 500; Cooper Techniflex SP 1000.

The submitted models, Cooper Techniflex SP 400 Jr., Cooper Techniflex SP 700, Cooper Techniflex 750, and Cooper Techniflex SP 900, are virtually identical to Bauer

Supreme SP 3000 in every significant respect. The Court's discussion of Bauer Supreme SP 3000 applies equally to the accused products in this group. The Court finds that there is no infringement by these products.

Velocity SP X 70; Velocity SP X 70J; Velocity SP X 90

Velocity SP X 70 and Velocity SP X 90 are virtually identical to Bauer Supreme SP 3000 in every significant respect. The parties agree for the purposes of this action that Velocity SP X 70J is the same as Velocity SP X 70 in all material respects. The Court's discussion of Bauer Supreme SP 3000 applies equally to these products. The Court finds that there is no infringement by these products.

Cooper CSB 1000 Cooperall; Cooper CSB 2000 Cooperall; Cooper CSB 3000 Cooperall; Cooper CSB 2 Cooperall; Cooper CSB Pro Cooperall

The parties submit the following samples and agree for the purposes of this action that they are the same in all material respects: Cooper CSB 1000 Cooperall; Cooper CSB 3000 Cooperall; Cooper CSB 2 Cooperall. They further agree for the purposes of this action that the following models, which have not been submitted to the Court, are the same as these samples in all material respects: Cooper CSB 2000 Cooperall; Cooper CSB Pro Cooperall.

Cooper CSB 1000 Cooperall and Cooper CSB 2 Cooperall are essentially formed of two pieces of moderately flexible padding formed in an upside-down "U" shape, one for the left side and one for the right. Each of the two pieces covers one half of the back, extends over the shoulder, and covers one half of the chest. They are encased in stretch fabric which is joined at the center front and back, thus forming a padded

structure for the chest, shoulders and back, open under the arms and with a hole in the center such that the product can be pulled on over the athlete's head. The stretch fabric extends out over the upper arm area on each side and contains separate pads for the upper arms. Pads for the shoulder, encased in stretch fabric, are attached by stitching to the outer fabric of the product. Wide elastic straps are stitched to each side of the back of the structure. These straps extend under the wearer's arms and may be attached to the front of the product by velcro-like fasteners.

Cooper CSB 3000 Cooperall is virtually identical to Cooper CSB 1000 Cooperall and Cooper CSB 2 Cooperall except that it is made up of one large front piece, one large back piece and a tight and a left shoulder piece, instead of two side pieces. It is similarly encased in stretch fabric, the arm and shoulder pads are connected in the same manner, and it is worn by the athlete by pulling on over the head and attaching the wide elastic straps under the arms.

Each of these products is essentially made up of the pads themselves, encased in stretch fabric and held in place on the upper body by elastic straps under the arms. There is no discernable separate garment apart from the fabric-encased pads. Nor are the pads held against the body by the stretchiness and tight fit of the product. Rather, they are held in place by virtue of being incorporated into a padded structure covering back, chest and shoulders and connected under the arms by straps.

In contrast, the 801 claims teach a stretch garment, made to fit tightly on the upper body like a shirt or other typical garment for the upper body. Even when the pads are inserted, a significant portion of the garment is not padded, its function being to provide a tight fit on the wearer's body serving to

hold the pads firmly in place over the portion of the body to be protected. The Court finds as a matter of law that the accused products do not read literally on Claim l(a) through (c) of the 801 patent because the accused products do not comprise tightly fitting body-coveting means for the upper body made of stretchable material, to which are affixed a plurality of pockets, into which are inserted pads which are held in place by the tight fit and stretchiness of the body covering means.

For the reasons set forth above in the discussion of Bauer Supreme SP 3000, the Court finds no basis for applying the doctrine of equivalents. Moreover, the distinction between prior art Cooper pads and the 801 claims, relied on by applicants in addressing the protest to their first patent application, gives rise to prosecution history estoppel with respect to the accused products in this group, particularly Cooper CSB 1000 Cooperall and Cooper CSB 2 Cooperall, because the prior art Cooper pads, particularly Cooper XL3ML, are remarkably similar to these accused products. Specifically, Cooper XL3ML, Cooper CSB 1000 Cooperall and Cooper CSB 2 Cooperall are made up of the pads themselves, encased in stretch fabric, essentially comprising two units, one over the left shoulder and one over the right, joined in front and back, and held in place on the upper body by straps under the arms. The statement by applicants in distinguishing prior art Cooper products, that "[t]here is no stretch garment, the pads do not conform to the body, and they are free to move and shift about the player's body" (emphasis added), is equally true of the accused products in this group. The Court finds that there is no infringement by these products.

CSB Cooper Super Pro Cooperall

CSB Cooper Super Pro Cooperall is virtually identical to Cooper CSB 1000 Cooperall and Cooper CSB 2 Cooperall in every significant respect. The Court's discussion of Cooper CSB 1000 Cooperall and Cooper CSB 2 Cooperall applies equally to this product. The Court finds that there is no infringement by this product.

Cooper CSB 3 Cooperall

Cooper CSB 3 Cooperall is virtually identical to Cooper CSB 3000 Cooperall in every significant respect. The Court's discussion of Cooper CSB 3000 Cooperall applies equally to this product. The Court finds that there is no infringement by this product.

Supreme SP 5000 1997

Supreme SP 5000 1997 is the same in all material respects as Cooper CSB 1000 Cooperall and Cooper CSB 2 Cooperall except that it is covered with rigid plates. Indeed, it very closely resembles Cooper SB96, a prior art product submitted by plaintiff on the motion, albeit constructed of different, presumably more modem, materials. Supreme SP 5000 1997 does not infringe the 801 patent for the same reasons that Cooper CSB 1000 Cooperall and Cooper CSB 2 Cooperall do not. Moreover, reading the 801 patent so broadly as to encompass Supreme SP 5000 1997 would destroy the basis for distinguishing the prior art Cooper shoulder pads. The Court finds that there is no infringement by this product.

Infringement: conclusion

As the patentee, plaintiff would bear the burden at trial of proving infringement by a preponderance of the evidence. Thus, although plaintiff is the non-movant on the summary judgment motion, plaintiff nevertheless has the burden to proffer evidence that the accused products contain every claim limitation either exactly or by a substantial equivalent. Although there are numerous disputed points in the parties' statements submitted in compliance with Local Rule 7.1(a)(3), all the facts relevant to the Court's determinations of infringement are undisputed. Much of the disputed material in the Rule 7.1 statements does not involve evidentiary facts and is within the Court's province. For example, the parties "dispute" the scope and meaning of the prior art patents, yet these patents are before the Court and their interpretation is a question of law for the Court. Moreover, samples of the accused products are before the Court. These products are not complex and the pertinent elements which allegedly read on the claims of the 801 patent can be easily perceived and understood by the layperson.[9] Therefore, there is no question of fact warranting a hearing on any issue relative to the question of infringement. *Compare, e.g., Upjohn Co. v. Mova Pharmaceutical Corp.*, 225 F.3d 1306, 1308-09 (Fed. Cir. 2000) (jury trial at which experts testified on question of

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[9] In support of their motion, the Bauer defendants submit the statement of David J. Pearsall, who tested certain accused products and concluded that they do shift on the wearer's body upon impact. The record does not enable the Court to evaluate the significance of the degree of shifting reported by Pearsall, to compare it to the performance of the 801 invention under the same conditions, or otherwise to assess its relevance to the question of infringement. Accordingly, the Court does not rely on this submission.

infringement of patent concerning anti-diabetic pharmaceutical composition). The Court makes its rulings as a matter of law based on the undisputed factual allegations and the evidentiary proof before it.

For the reasons set forth above, the Court holds that the Bauer defendants are entitled to summary judgment dismissing all claims of infringement of the 801 patent by all products which are the subject of this action.

II. PATENT VALIDITY

Generally

Once granted, a patent is presumed valid. See 35 U.S.C. § 282. A party challenging a patent has the burden to show invalidity by clear and convincing evidence. *See Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1375 (Fed. Cir. 1986). Where the challenger relies only on evidence which was considered by the patent examiner, he has "the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job...." *American Hoist & Derrick Co. v. Sowa & Sons*, 725 F.2d 1350, 1359 (Fed. Cir. 1984). Even where the challenger introduces evidence not before the examiner, however, the presumption of validity remains intact, the burden remains on the challenger, and the clear and convincing standard does not change. *Hybritech*, 802 F.2d at 1375. If the challenger fails to meet his burden, the court need not declare a patent valid but only that the party challenging it has not carried his burden of showing that it is invalid, *see Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567 (Fed. Cir. 1983), even where, as here, invalidity is asserted in a counterclaim. *See, e.g., Rosemount, Inc. v.*

Beckman Instruments, Inc., 727 F.2d 1540, 1543, n. 2 (Fed. Cir. 1984).

Patentability depends on three statutory conditions: novelty, 35 U.S.C. § 101; utility, 35 U.S.C. § 102; and nonobviousness, 35 U.S.C. § 103. The dispute concerning validity of the 801 patent centers on the nonobviousness requirement of section 103,[10] which the Supreme Court explains as follows: "An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent.... [Section 103] refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before .... If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented." *Graham v. John Deere Co.*, 383 U.S. 1, 14-15 (1966).

The mere fact that combining teachings of prior art can lead to the claimed invention does not necessarily render the invention obvious. *See Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed.Cir.1997). Indeed, the Federal Circuit has observed that "invention itself is the process of combining prior art in a nonobvious manner." *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998). "The

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[10] 35 U.S.C. § 103 provides in part:

> A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ....

consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art." *In re Dow Chem.*, 837 F.2d 469, 473 (Fed. Cir. 1988). Thus, the legal determination of obviousness often depends on such factual considerations as the scope and content of the prior art, the differences between the invention and the prior art, and the level of ordinary skill in the field of the invention. *See Graham,* 383 U.S. at 17-18.

Other factual considerations relevant to the question of obviousness concern "how the patented device is viewed by the interested public: not the inventor, but persons concerned with the product in the objective arena of the marketplace." *Arkie Lures,* 119 F.3d at 957. Such considerations, often referred to as objective, or secondary, considerations, may include the commercial success of the patented invention, licensing activity, whether the invention addresses "long felt but unsolved needs," and the failure of others to produce alternatives to the patented invention. *See id.* As the Federal Circuit stated:

> Indeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decisionmaker remains in doubt after reviewing the art.

Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538-39 (Fed. Cir. 1983). The weight to be given to such evidence depends on the patentee's showing of a nexus between the

evidence and the merits of the invention. *See In re GPAC*, 57 F.3d 1573, 1580 (Fed. Cir. 1995).

Patent invalidity - summary judgment

A patent is presumed valid and, therefore, nonobvious. *See Kahn v. General Motors Corp.*, 135 F.3d 1472, 1480 (Fed. Cir. 1998). A moving party seeking to invalidate a patent on summary judgment must present such clear and convincing evidence of invalidity that no reasonable jury could find otherwise. *See Eli Lilly and Co. v. Barr Lab., Inc.*, 2001 WL 578859, *5 (Fed. Cir. 2001).

The motion

The Bauer defendants assert that the claims in the 801 patent were obvious from a combination of prior art, specifically, the teachings of the patent owned by John Livernois (U.S. Patent 4,325,148) (1982) combined with the teachings of Allen E. Kennedy's patent (U.S. Patent 2,163,463) (1939) or with those of Don B. Bennett's patent (U.S. Patent 3,127,614) (1964), or from a combination of the prior art Cooper shoulder pads with the teachings of either the Kennedy or the Bennett patent. The Court thus considers whether, in light of the prior art, the 801 invention was obvious at the time, that is, whether the prior art would have suggested to one of ordinary skill in the art that this product should be made and would have a reasonable likelihood of success. The Court first addresses the level of ordinary skill in the pertinent art, then the scope and content of each item of prior art and the differences between prior art and the claims at issue, and finally the objective evidence.

Level of ordinary skill

The Court must cast its mind "back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *In re Kotzab,* 217 F.3d 1365, 1369 (Fed. Cir. 2000). Plaintiff states in his affidavit that prior to the filing of the patent application in 1982 he supervised athletic training and physical therapy at Cornell University. He was a certified athletic trainer with a Bachelor of Science degree in physical therapy and a Master of Education degree with emphasis in sports medicine, and experience in design and construction of shoulder pads. He stayed informed of literature on the subject, regularly attended athletic equipment trade shows and reviewed sports equipment catalogs. The Bauer defendants do not dispute that plaintiff was a person of ordinary skill in the art at the time. They state in their brief: "Persons of ordinary skill in this art were familiar with the anatomy of the human shoulder, with the types of shoulder injuries sustained by athletes, and with the protective equipment available to protect athletes from such injuries.... [They] tended to keep abreast of the various protective garment products and the various means to protect athletes from injury." The court adopts this description, which is consistent with plaintiff's affidavit.

The evidence in the prior art patents and the prosecution history of the 801 patent, including the affidavits of Drs. Zelko and Yale, support plaintiff's averment that people skilled in the art at the time were aware of only two methods of protecting the athlete in impact sports: foam padding held against the body by a stretch garment or hard-shell padding held in place either by straps or by being attached to a rigid armor-type product. Virtually all efforts to protect the A-C joint fell into the latter category, including the Cooper prior

art and the arching shoulder pads created by Bennett and Kennedy, and, according to Drs. Zelko and Yale, had the disadvantages of those products, including shifting and lack of flexibility.

Livernois - scope and content, comparison to 801 patent

In considering the scope and content of the prior Livernois patent, the Court observes that it teaches a protective inner garment for ice hockey players constituting a stretch garment for the lower body containing pockets for the insertion of protective pads located over the areas of the lower body to be protected. The pockets have openings for insertion and removal of pads according to player preference.

During prosecution of the 801 patent, the examiner initially rejected the application based in part on the Livernois prior art. The applicants responded by distinguishing Livernois on the ground that it limits its teachings to the lower part of the body and specifies that conventional pads be used on the upper body. The examiner did not approve the 801 application, however, until the applicants further amended their claim to teach a pad bridged over the A-C joint of the shoulder, leaving a gap between the top of the shoulder and the pad, whereby impact forces are transferred to the pectoral and trapezius muscles.

In comparing the prior art of the Livernois invention to the claims at issue, the Court notes that the Livernois pads are held in place by the garment such that they rest upon the area to be protected. At the moment of impact, the pads remain in contact with the area to be protected and provide protection by absorbing some of the impact. Although it teaches the use of stretch fabric to form a garment and the use of pads in pockets

on that garment, the Livernois patent does not address the problem of protection by means other than padding resting directly on the area to be protected and thus does not teach the use of an arched pad intended to avoid contact with the joint. In contrast, a critical factor in the 801 invention is the arched shape of the pad, which averts contact with the A-C joint and directs the force of impact to the chest and back of the wearer. Such protection could not be afforded by merely inserting a conventional pad into the shoulder portion of a stretch garment such that the pad rests against the wearer's shoulder, in the manner suggested by Livernois. Indeed, it was only after the applicants amended claim one by adding the limitation concerning the arched shoulder pad that the examiner approved the 801 patent. The prosecution history makes clear that the examiner fully considered the Livernois patent, and his implicit determination that the amendments rendered claim one nonobvious in light of Livernois is entitled to some degree of deference.

Biggs - scope and content, comparison to 801 patent

In their response to the examiner's second rejection of their application, the applicants brought to the examiner's attention the patent of Ernest R. Biggs, Jr. In considering the scope and content of the Biggs patent, the Court notes that it shows a relatively rigid U-shaped shoulder pad over the A-C joint. The front and back portions of the pad rest on the pectoral and trapezius muscles and transmit force to those areas. The pad is not incorporated into a stretch garment - rather, it is shown in the illustration as held in place by a strap. In distinguishing their invention from Biggs during prosecution of the 801 patent, the applicants pointed out that because the Biggs pad is not held in position by a pocket in stretch material so as to maintain a space between the top of the shoulder and the pad, the Biggs pad required a "reverse

curve" for the center portion in order to maintain its U-shape over the A-C joint.

Comparison of the claims in the Biggs patent to the 801 claims demonstrates that not only is the reverse-curve mechanism different from the subject invention, but the fact that the Biggs product is not incorporated into a tightly-fitting stretch garment but held in place by a strap suggests that it would tend to shift like conventional shoulder pads and that it would not meet the "need for freedom of movement in the shoulder joint" cited by Drs. Zelko and Yale. Indeed, insofar as the shoulder pads are not incorporated into a garment or other fitted structure for the upper body, the Biggs patent teaches away from the 801 patent.

Kennedy - scope and content, comparison to 801 patent

The Kennedy patent was not expressly considered by the examiner in reviewing the subject application.[11] The invention is intended to protect the shoulders and ribs during athletic activity, particularly football. It teaches combining shoulder and rib protection into one jacket-like product and consists of a padded stiffened vest with attached shoulder protectors. Each shoulder protector forms a U-shape over the A-C joint, but does not contain a reverse curve as in Biggs. The Kennedy shoulder protection comprises three parts: a "bridge" portion arching above the portion of the shoulder nearest the neck and extending down the wearer's chest and back, a "cupped"

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[11] Plaintiff urges that the Kennedy and Bennett patents were before the examiner by virtue of the "Field of Search" listing at the beginning of the patent. Whether the examiner actually reviewed or considered these patents cannot be determined from the record before the Court.

shoulder cap, which covers the outer part of the shoulder, and a "closure" plate, which rests on top of the other two portions. The bridge portion is attached to the vest by stitching in a manner so as "to firmly support said bridge members in said spaced relationship to said shoulder portions." According to the specifications, the mode of attachment of the bridge portion to the vest is intended to transmit the force of an impact down into the remainder of the product and to prevent compression of the bridge member to the extent that it would touch the shoulder. The specifications state that all three shoulder portions are made of stiff material such as leather or molded fiber. The Kennedy invention seeks to protect the clavicle and A-C joint by encasing them in a stiffpad which arches above the A-C joint and is incorporated into a structure in such a way as to prevent compression of the pad. The body of the product is stitched, padded and, in the rib area, supplemented with stiffeners. Due to the rigid nature of the shoulder pad and the structure, the Kennedy patent teaches armor-type protection. The Kennedy patent, in which the force of impact is intended to be absorbed by the stiff structure instead of by the muscles of the back and chest, differs significantly from the 801 patent, which teaches that the force of impact is absorbed by the muscles of the back and chest. Because the Kennedy pad is held in place on the wearer's body by a stiff structure, it appears more likely to shift position and more likely to restrict the wearer's movement than the 801 invention. The fact that the Kennedy shoulder pad is incorporated into a stiff armor-type structure teaches away from the 801 patent.

Bennett - scope and content, comparison to 801 patent

The Bennett invention was not expressly addressed by the examiner in reviewing the subject application.[12] It comprises a football shoulder protector and foam liner. The shoulder protector is rigid and designed to arch above the A-C joint in a U-shape. It is supported with inside cantilever elements and is attached to rigid front and back plates to form a rigid structure. The foam liner is made from a spongy material which, when worn inside the shoulder pad, comes into contact with the chest and back of the wearer. The liner contains recesses in those sections which would otherwise come into contact with the clavicle and A-C joint, such that the force of an impact will cause pressure on all other parts of the shoulder except those corresponding to the recesses.

The Bauer defendants argue that because the applicants distinguished the Biggs invention based on the presence of a reverse curve, the use of a cantilever arch in the Bennett invention instead of a reverse curve makes the Bennett invention "more relevant" to the obviousness issue presently before the Court. This assertion is questionable inasmuch as the specifications of the Biggs patent describe its reverse-curve structure as a "cantilever arch." In any event, whether the structure is held in a U-shape by a reverse curve or a cantilever mechanism is immaterial; the outer Bennett structure offers rigid armor-type shoulder protection, which appears less flexible and more likely to shift than the 801 invention. This characteristic teaches away from the 801 invention, as does the fact that the foam liner is not incorporated into a garment but must be worn inside an armor-type structure.

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[12] See n. 11, supra.

Watkins article

The article by Susan M. Watkins, "The Design of Protective Equipment for Ice Hockey," *Home Economics Research Journal,* vol. 5, no. 3, pp 154-66 (March 1977), suggests only a stretch body suit containing pads in pockets for lower body protection, over which the athlete wears shoulder pads attached to the bodysuit by velcro-like fasteners, and hip and rib pads attached by buttons. Due to the absence of an arching shoulder pad protecting the A-C joint, and the different manner of holding the shoulder pad in place, the protection proposed in the Watkins article differs significantly from the 801 invention.

Cooper - scope and content, comparison to 801 patent

The Bauer defendants also assert that plaintiff's invention is obvious from the teachings of the prior art Cooper shoulder pads combined with either the teachings of the Kennedy patent or those of the Bennett patent. Two of the prior art Cooper models, XL3ML and SB96, were submitted to the Court as samples. They are structures comprising fairly rigid front and back padding, to which are attached fairly rigid shoulder and arm pads. Each pad is separately covered by stretch fabric, and then the separate fabric-covered pads are sewn, strapped or laced together. The product is essentially made up of the pads themselves, encased in stretch fabric, and then attached to each other to form a structure. The Cooper model XL3ML is notably similar to two accused products, Cooper CSB 1000 Cooperall and Cooper CSB 2 Cooperall.

In contrast, the 801 patent teaches what is fundamentally a stretch garment, made to fit the upper body like a shirt or other typical garment for the upper body. Even when the pads are inserted, a significant portion of the garment is not

padded, its function being to provide a tight fit on the wearer's body, thereby holding the pads in place.

The Cooper prior art differs significantly from the 801 patent because the fact that the Cooper products are not incorporated into a tightly-fitting stretch garment but held in place by being incorporated into a fairly rigid structure suggests that they would tend to shift like conventional shoulder pads and that would not meet the "need for freedom of movement in the shoulder joint" cited by Drs. Zelko and Yale. Indeed, even when they are viewed in combination with Kennedy or Bennett, the Cooper products teach away from the 801 patent to the extent that they are not incorporated into a garment or other fitted structure for the upper body.

Summary: prior art

While the Bauer defendants have introduced evidence of prior art which was not before the examiner, or at least not expressly placed before or considered by him, this Court finds no significant element or combination of elements present in the unconsidered prior art which was not present in the considered prior art. Thus, the state of the prior art as submitted to this Court is not significantly different from that which was considered by the examiner. As is plain from the prosecution history of the 801 patent, the examiner thoroughly considered whether the combination of stretch garment with arched shoulder pads in the manner of the 801 patent was obvious, and concluded that it was not. The two experts whose affidavits applicants submitted to the examiner reached the same conclusion.

The Biggs invention, a fairly rigid shoulder pad maintaining an arching U-shape over the shoulder, suggests the arching shoulder pad in the 801 invention. Insofar as the

shoulder pads are not incorporated into a garment or other fitted structure for the upper body, however, the Biggs patent teaches away from the 801 patent.

The Bennett invention is made up of a rigid outer protective structure and separate foam liner to be worn inside the structure. While Bennett suggests the use of arching pads over the A-C joint, the outer Bennett structure offers rigid armor-type shoulder protection, which teaches away from the 801 invention, as does the fact that the foam liner must be worn inside an armor-type structure and is not incorporated into a garment.

The Kennedy shoulder pad, in which the force of impact is absorbed by the stiff structure to which the pads are attached, differs significantly from both Biggs and the 801 patent, both of which teach that the force of impact is absorbed by the muscles of the back and chest. Although the Kennedy invention is incorporated into a vest-like structure, it is a stiff structure which offers armor-type protection. To this extent it teaches away from the 801 invention.

The Cooper prior art, which applicants characterized as conventional football style shoulder pads with no stretch garment, also teaches away from the 801 invention to the extent that it is a fairly rigid structure and lacks a stretch garment.

From prior art[13] it appears that there were essentially two methods of protecting the athlete in impact sports: foam padding held against the body by a stretch garment (as in Livernois or the Watson proposal), or hard-shell protection held in place either by straps (as in Biggs) or by being attached to an armor-type structure (as in Kennedy, Cooper and Bennett). It has not been clearly established on this record that the teachings of the Biggs, Kennedy or Bennett patents, even when viewed in combination with each other, with the Cooper prior art, or with the Livernois invention or the Watson proposal, suggest combining the two types of protection to provide protection in the manner of the 801 patent. Particularly in view of the objective evidence, discussed below, a factfinder could well find after trial that no prior art or combination thereof showed or suggested the 801 invention as a whole.

Objective (or secondary) evidence of nonobviousness

The record before this Court, which demonstrates that developments in the field of athletic protection were few and

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[13] The Bennett 34 Body-Gard, a protective body suit for the upper body, was disclosed by applicants in connection with their second application. It is made of stretchable material, with pads protecting the shoulders, ribs and spine. It does not have an arching shoulder pad protecting the A-C joint; rather, the pads rest on the body as do the pads in the Livernois garment. The applicants' submission to the examiner stated that the "Bennett Body-Gard garment uses a different design of shoulder pad ... but is otherwise similar to the subject invention." The record contains no patent for this garment. According to applicants, it was developed in the summer of 1983, almost a year after they applied for the 801 patent, and thus is not prior art. The Bauer defendants do not contend that it is prior art.

far between (the Kennedy patent was issued in 1939; the Bennett patent in 1964; the Biggs patent in 1970; and the Livernois patent in 1982), suggests that the 801 invention was not obvious from the prior art. Plaintiff submits a letter from John Cooper, president of Cooper Canada, Ltd., to Doc Kavanagh dated March 29, 1983, stating that his company "ha[d] been doing a great deal of work in developing a "hard shell' hockey shoulder pad to respond to the tremendous increase" in shoulder injuries due to recent changes in the hockey game. Cooper's letter indicates that his company, at least, was pursuing a different means of protection than that taught by the 801 patent, and that to at least some people of ordinary skill in the art the subject matter of the 801 patent as a whole was not obvious. Plaintiff also submits evidence that the 801 invention enjoyed financial success and has been successfully sold by five licensees, and that sales of allegedly infringing products amounted to at least $15 million since 1985. Thus, there is some evidence suggesting that, as stated by plaintiffs' experts, Drs. Zelko and Yale: "The solution appears simple, but this is true only after someone thought to try it and it worked." The same evidence further suggests that the problem of A-C protection which afforded flexibility and did not shift presented a long felt need which others had failed to solve.

Plaintiff's submissions are sufficient to make out a *prima facie* showing of a nexus between objective evidence of nonobviousness, such as licensing and financial success, and the merits of the 801 invention. To the extent that plaintiff can demonstrate such a nexus, his objective evidence of nonobviousness will be entitled to more or less weight. *See GPAC,* 57 F.3d at 1580.

Conclusion: claim one

The Court, having conducted an in-depth review of the record, including the 801 patent itself, the prosecution history, the patents pertaining to prior art, the examples submitted to the Court, and the evidence of secondary considerations, and viewing the evidence in the light most favorable to plaintiff and resolving all doubts in his favor, concludes that the Bauer defendants have failed to submit such clear and convincing evidence of invalidity that no reasonable jury could find otherwise. Accordingly, they are not entitled to summary judgment on the ground of invalidity.

Conclusion: claims two through nine

Claims two through nine are dependent upon and add further elements to claim one. On this record, by virtue of their failure to establish by clear and convincing evidence that claim one is obvious, the Bauer defendants have also failed to demonstrate their entitlement to summary judgment determining that claims two through nine are invalid.

CONCLUSION

The Court holds that the Bauer defendants are entitled to summary judgment dismissing the complaint on the ground that as a matter of law their products do not infringe the 801 patent. The Court further holds that the Bauer defendants have failed to present such clear and convincing evidence of the invalidity of the 801 patent that no reasonable jury could find otherwise. Therefore, the Court does not reach the other issues raised on the motions.

It is therefore

ORDERED that so much of the motion by the Bauer defendants as seeks summary judgment dismissing the complaint on the ground that the products in issue do not infringe the claims of U.S. Patent 4,507,801 is granted; and it is further

ORDERED that the complaint is dismissed; and it is further

ORDERED that so much of the motion by the Bauer defendants as seeks summary judgment on their counterclaim in their answer to the first amended complaint seeking declaratory judgment that U.S. Patent 4,507,801 is invalid is denied; and it is further

ORDERED that the action will proceed upon the counterclaim in the Bauer defendants' answer to the first amended complaint, and plaintiff's answer to the counterclaim; and it is further

ORDERED that the motion by the Bauer defendants to preclude plaintiff from recovering pre-suit damages for failure to comply with the marking and notice requirements of 35 U.S.C. § 287(a) is denied as moot; and it is further

ORDERED that plaintiff's cross motion for leave to serve a second amended complaint to plead compliance with 35 U.S.C. § 287(a) is denied as moot.

IT IS SO ORDERED.

July 5, 2001
Syracuse, New York

/s/
Hon. Norman A. Mordue
United States District Judge

(3)

No. 05-1360

FILED

MAY 30 2006

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SUPREME COURT, U.S.

In The

Supreme Court of the United States

BERNARD F. DEPALMA,

Petitioner,

v.

NIKE, INC., BAUER NIKE HOCKEY, INC., AND BAUER NIKE HOCKEY USA,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION

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QUESTION PRESENTED

Petitioner's lengthy statement of the questions presented attempts to create issues of constitutional law and to manufacture conflicts with Supreme Court precedent and other circuit courts where none exists.

Restated, the question presented is whether this Court should review the Federal Circuit's judgment affirming the District Court's grant of summary judgment where the Petitioner had notice and an opportunity to respond to Respondents' summary judgment motion and noninfringement was demonstrated as a matter of law?

PARTIES TO THE PROCEEDINGS BELOW AND RULE 29.6 STATEMENT

The parties to the proceedings below are Petitioner Bernard F. DePalma; Respondents Nike Inc., Bauer Nike Hockey, Inc., and Bauer Nike Hockey USA; and Sherwood Drolet Corporation.

Pursuant to Supreme Court Rule 29.6, Respondents state that Bauer Nike Hockey, Inc. and Bauer Nike Hockey USA are wholly owned subsidiaries of Nike, Inc., through various other intermediate corporations. There are no other publicly held companies that own 10 percent or more of the stock of any of the Respondents.

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PRELIMINARY STATEMENT

This case presents no issue worthy of review by the Supreme Court. The judgment does not conflict with the decision of any other court, involves no real question of constitutional law, and presents no important question of federal law. This case is merely an instance of an appellate court reviewing summary judgment and determining, in accordance with established standards of review, that judgment was correct as a matter of law.

Petitioner DePalma attempts to create constitutional issues and conflicts between the decisions below and other precedent by asserting that the district court granted summary judgment *sua sponte* and without proper notice. DePalma's premise, however, is faulty. DePalma had notice through Respondents' (collectively referred to as Bauer) motion for summary judgment and was given numerous opportunities to respond. In time, DePalma did respond to the motion. The district court held a hearing and entered judgment on a ground raised in Respondents' motion. As a result, DePalma was not denied due process or an opportunity to be heard, and the decision below is in accord with established precedent.

DePalma's real complaint is with the specific finding that his patent claims do not cover Bauer's products, which raises no constitutional question or important question of federal law. As such, it is nothing more than the familiar refrain of a losing litigant in a patent appeal. DePalma's petition for writ of certiorari also mischaracterizes the record. If the Court were to mistakenly grant the petition based on the issues presented by DePalma, it would later discover that the case is nothing like that described in his petition for certiorari.

COUNTERSTATEMENT OF THE CASE

DePalma brought suit for infringement of U.S. Patent No. 4,507,801 (the '801 patent) on October 5, 1995. In defense, Bauer asserted, *inter alia*, that its products did not infringe the '801 patent and that the patent was invalid.

Bauer first moved for summary judgment of non-infringement and invalidity in December 1996, after the close of discovery. (Ct. App. JA 67.) At DePalma's request, the Magistrate Judge allowed DePalma to conduct depositions outside of discovery and extended DePalma's deadline to oppose Bauer's summary judgment motions. (Ct. App. JA 67, 104.) On May 2, 1997, the Magistrate Judge again extended the deadline for DePalma's oppositions. (Ct. App. JA 68, 107.)

Despite the twice-extended deadlines, DePalma failed to respond to Bauer's summary judgment motions, and the Magistrate Judge issued an order precluding DePalma from filing responses. (Ct. App. JA 69, 107-08.) On appeal of this order, the district court, recognizing DePalma's lack of diligence but also recognizing the severe nature of the sanction, remanded the matter back to the Magistrate Judge to set yet another deadline for DePalma's response to the outstanding summary judgment motions. (Ct. App. JA 70, 112.)

Under an amended scheduling order, Bauer filed a combined motion for summary judgment of noninfringement, invalidity, and failure to comply with the marking and notice requirements of 35 U.S.C. § 287(a) in February 2000. (Ct. App. JA 74.) DePalma filed his opposition to the motion in March 2000, over three years after Bauer first moved for summary judgment. (Ct. App. JA 74.) Although

DePalma is the patent owner and would ultimately have the burden of proof on the issue of infringement, DePalma elected not to propose any construction for the claim terms at issue. Instead, DePalma merely argued that Bauer's proposed constructions of the '801 patent claims were incorrect. (Ct. App. JA at 592-99.)

The district court held a hearing on Bauer's motion on June 7, 2000, and DePalma participated in that hearing. The district court then issued its Memorandum-Decision and Order construing the claims of the '801 patent, granting summary judgment of noninfringement, denying summary judgment of invalidity, and denying all other issues as moot. (Pet. App. 57a.)

In its Memorandum-Decision, the district court construed claim 1 of the '801 patent and then applied that construction to the accused hockey pads. (Pet. App. at 30a-42a.) The court concluded that no reasonable jury could consider Bauer's hockey pads as containing elements (a)-(c) of claim 1 because they do not have the claimed "tightly fitting body-covering means made of stretchable material," or the claimed "plurality of pockets affixed to the body covering means" and "located in the portion of the body-covering means covering the body portion to be protected." (Pet. App. at 34a.) Bauer had specifically identified these limitations as lacking from the accused products and thus raised the very grounds on which judgment was based. (Ct. App. JA at 137-43.)

The district court explained that the accused "product is essentially made up of the pads themselves, encased in a stretch fabric and joined closely together by various means" and that there "is no discernable garment apart from the fabric-encased pads." (Pet. App. at 33a.) Bauer

had made this same argument, contending that the accused pads, like prior art pads, are simply pads covered in stretch material which are stitched together and attached with straps. (Ct. App. JA at 138-40.)

On appeal to the Federal Circuit, DePalma argued the merits of the judgment against him and further argued that the district court construed the claims of the '801 patent *sua sponte* and entered judgment on a ground not raised in Bauer's motion. (Ct. App. Br. at 27.) The Federal Circuit, after briefing and oral argument, summarily affirmed the judgment of the district court.

REASONS FOR DENYING THE WRIT

I. DePalma Had Notice and an Opportunity to Be Heard

DePalma's petition should be denied because DePalma has not presented an issue worthy of Supreme Court review. DePalma attempts to demonstrate a split among the circuit courts regarding the notice required before summary judgment may be entered and the evidentiary burden placed on the party opposing summary judgment. It is not clear that DePalma has demonstrated such a conflict, but, in any event, it is irrelevant because DePalma had notice and numerous opportunities to respond to Bauer's motion.

This is not the situation where Bauer moved for summary judgment of noninfringement and the court entered judgment of invalidity or where the court, acting on its own, entered judgment *sua sponte*. Bauer moved for summary judgment of noninfringement, contending that the accused products did not meet certain claim limitations.

And the district court entered judgment of noninfringement, holding that those claim limitations were absent from the accused products.

Moreover, over the course of three years, DePalma was given numerous opportunities to respond to Bauer's motion, and DePalma did file an opposition. The district court held a hearing, where DePalma again had an opportunity to be heard on his opposition to summary judgment. Thus, DePalma did in fact have notice of the basis for the judgment against him and had more than ample opportunity to marshal evidence against such judgment.

In addition, the Federal Circuit considered the same notice argument that DePalma presents here. The Federal Circuit, being in the position to review the record and determine the level of notice provided to DePalma, summarily entered judgment pursuant to Federal Circuit Rule 36, thereby finding that the record supported summary judgment and that an opinion would have no precedential value.

Nothing in this case demonstrates that DePalma was denied due process in any way or implicates a split between the circuit courts. DePalma is simply a litigant who wishes that the law applied to the undisputed facts in this case resulted in a different outcome. Merely asserting that the law has been misapplied, however, does not create a ground for certiorari, as DePalma himself acknowledges (*see* Pet. at 8-9).

II. Construing Patent Claims in Connection With Summary Judgment Is Proper

DePalma criticizes the district court for construing the claims of the '801 patent at the same time it considered Bauer's motion for summary judgment. DePalma asserts that district courts should be required to construe patent claims before receiving motions for summary judgment. (Pet. at 24-27.) In other words, DePalma seeks a special rule for summary judgment in patent cases. In no other area of the law is a court required to announce the law that will be applied before it receives motions for summary judgment and nothing particular to patent law requires such a special rule.

In *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 391 (1996), this Court held that claim construction is a question for the court but nothing in that decision suggests that claim construction must be announced prior to filing summary judgment motions. The Federal Circuit has also declined to establish a special rule as to how or when patent claims must be construed during a case. *See, e.g., Ballard Med. Prods. v. Allegiance Healthcare Corp.*, 268 F.3d 1352, 1358 (Fed. Cir. 2001) (stating that "*Markman* does not require a district court to follow any particular procedure in conducting claim construction"). The Federal Circuit has indicated that courts should have the discretion to interpret claims at an appropriate time in the proceeding, including in connection with summary judgment. *See, e.g., Ballard*, 268 F.3d at 1358 (affirming summary judgment and stating that "District courts have wide latitude in how they conduct the proceedings before them, and there is nothing unique about claim construction that requires the court to proceed according to any particular

protocol"); *Vivid Techs., Inc. v. Am. Science & Eng'g, Inc.*, 200 F.3d 795, 803-04 (Fed. Cir. 1999).

Moreover, district courts routinely construe claims in connection with summary judgment. *See, e.g., Utah Med. Prods., Inc. v. Clinical Innovations Assocs., Inc.*, 79 F. Supp. 2d 1290, 1299 (D. Utah 1999) (stating that "[a]s a practical matter, this Court finds that combining the *Markman* hearing and the motion for summary judgment is an efficient and sensible approach to what could otherwise be an unnecessarily lengthy and multi-phased process"), *aff'd*, 251 F.3d 171 (Fed. Cir. 2000); *Mediacom Corp. v. Rates Tech., Inc.*, 4 F. Supp. 2d 17, 22, 22 n.2 (D. Mass. 1998) (stating that "[s]ince *Markman* claim construction has most frequently been handled in conjunction with a hearing on a motion for summary judgment" and that a "Rule 56 summary judgment is a perfectly appropriate vehicle in which to conduct a *Markman* hearing"); *Genentech, Inc. v. Boehringer Manneheim GmbH*, 989 F. Supp. 359, 364 (D. Mass. 1997) (stating "[m]any courts address claim construction and summary judgment in a single opinion").

In this case, DePalma had the opportunity to offer proposed claim constructions but chose not to do so. The district court considered Bauer's proposed constructions, DePalma's arguments against those constructions, the '801 patent, its prosecution history, and the evidence presented in connection with claim construction and summary judgment. And the court arrived at a proper claim construction. Nothing in this procedure deprived DePalma of notice or an opportunity to respond. Although DePalma criticized the district court's claim construction on appeal, calling it *sua sponte*, he notably did not offer any claim construction of his own. Thus, even when given numerous opportunities, DePalma has been unable to

identify any error in the court's construction, showing that the judgment against him was not due to lack of notice but to the law and facts not supporting his claim.

III. The New Appellate Rules Do Not Apply

DePalma argues that this Court should address Federal Circuit Rule 36, which permits summary affirmance, and Federal Circuit Rule 47.6, which limits citation of nonprecedential opinions, in view of the recent changes to the Federal Rules of Appellate Procedure. New Rule 32.1 of the Federal Rules of Appellate Procedure will only apply to decisions after January 1, 2007, however, and thus does not apply to this case. DePalma essentially asks this Court to extend new Rule 32.1 to decisions issued prior to January 1, 2007, but the Judicial Conference considered that very issue and declined to extend the rule to such decisions. *Compare* Fed. R. App. P. 32.1 (2006) *with* Memorandum from Judge Samuel A. Alito, Jr., Chair, Advisory Comm. on Appellate Rules, to Judge David F. Levi, Chair, Standing Comm. on Rules of Practice & Procedure (May 6, 2005) (*available at* http://www.uscourts.gov/rules/Reports/AP5-2005.pdf).

Moreover, nothing in the Federal Circuit's use of Federal Circuit Rule 36 in this case creates a constitutional issue or a question of importance for this Court. To the contrary, the rule itself provides that it is only used when the record supports the judgment and an opinion would have no precedential value. Because this case only involves applying the '801 patent claims to the undisputed facts of this particular case, there is no precedent setting issue that requires a detailed precedential opinion.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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In the Supreme Court of the United States

BERNARD F. DEPALMA,

Petitioner,

v.

NIKE, INC., BAUER NIKE HOCKEY, INC., AND BAUER NIKE HOCKEY USA,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITIONER'S REPLY BRIEF

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I

Petitioner Bernard F. DePalma ("DePalma") submits this brief in reply to the brief of respondents Nike, Inc., Nike Bauer Hockey, Inc., and Bauer Nike Hockey USA (together "Bauer") opposing the petition for certiorari.

In revisiting the history of the case prior to Bauer's motion for summary judgment in the district court and arguing that DePalma had ample opportunity to respond to Bauer's *motions*, *viz.*, their initial summary judgment motions (which were denied),[1] as well as their later motion following which the district court granted summary judgment (Resp. Br. at 1-4), Bauer evasively misses the point of DePalma's petition and, therefore, fails to address the importance of the questions raised by this case.

The questions raised by DePalma's petition are premised upon the district court's failure to notify DePalma of the grounds upon which it ultimately granted summary judgment *sua sponte* against DePalma, *not* upon whether DePalma had adequate opportunity to address the points raised in Bauer's motion.

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[1] Bauer's effort to paint DePalma as a dilatory litigant saved only by the compassion of the court (Resp. Br. at 2), is directly belied by the very record cited by Bauer. There, Second Circuit Judge (previously, presiding District Judge) Pooler found the magistrate's order, forbidding DePalma to respond to Bauer's first set of summary judgment motions, to have been an abuse of discretion in view of Bauer's recalcitrance in discovery and DePalma's counsel's reasonable belief that the time to respond to Bauer's initial motions had been extended pending Bauer's compliance with its discovery obligations. It ordered that Bauer comply with discovery, and denied Bauer's summary judgment motions without prejudice to renew, which they did but on different grounds. "Ct. App. JA" at 103-14.

Bauer's contentions (Resp. Br. at 3) that DePalma did not proffer a construction of his patent claim as excluding the "element" that the district court, without prior notice, imported into the claim and ultimately found absent from Bauer's protective shoulder garments as its ground for summary judgment of non-infringement, emphasizes the importance of the questions presented to this Court and the appropriateness of this case as a vehicle for resolving them.[2] DePalma could not have anticipated the district court's ground of non-infringement, not only because Bauer did not raise the ground in their summary judgment motion but, also, because it was based upon an element or "limitation" not expressed in the patent claim but, rather, improperly imported into the claim from the drawings. While there are scores of detailed properties depicted in the drawings and described in the specification of the DePalma patent that the district court might have erroneously imported into the claim to support its judgment of non-infringement, DePalma had no prior notice of the one upon which the district court would ultimately rely.[3]

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[2] DePalma proffered a proper construction of his entire patent claim, including each of the elements expressly recited in claim 1 of his patent, as well as specifically rebutting the five grounds of alleged non-infringement based upon the construction proffered by Bauer on its motion, both in the district court an on appeal.

[3] Bauer's contentions (Resp. Br. at 3-4 and 4-5), that the district court ultimately based its summary judgment on the claim elements argued by Bauer in their motion, is simply untrue. The portions of the joint appendix cited by Bauer (*id.* at 4) in no way support their attempt to take credit for arguing the grounds upon which summary

Having confidence in their efforts to mislead the Court in that regard, Bauer made no effort whatsoever to rebut DePalma's showing that his petition raises important questions

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judgment was ultimately based. The section of Bauer's summary judgment motion to which they cite relates to one of Bauer's proffered bases of non-infringement (each of which the district court rejected at 27a - 30a), *viz.*, that their garments were not in the form of a shirt, vest, or similarly recognized wearing apparel:

> Specifically, none of these pads include a shirt or vest that conforms to the wearer's upper body. As such, none of these models literally infringe claim 1 of the '801 patent. Both Professor Pearsall and Mr. Bourque observed that the accused models have no shirt or vest, as required by the '801 [DePalma] patent. This distinction is apparent from a review of the '801 patent drawings.... *[T]he garment aspect of the accused [Bauer] models clearly is not a shirt or vest* conforming to the wearer's body. ["Ct. App. JA" at 137-40 (emphasis added)]

That is precisely how the district court understood Bauer's argument, rejecting their proffered narrow claim construction and ground of non-infringement:

> The Court does not read the 801 patent as limited specifically to "shirt" or "vest." As the Court reads the claims, specifications, and prosecution history, the requirements regarding the form of the body covering means, or garment, relate to its function.... [Petition Appx. at 30a]

Indeed, Bauer's admission that their products did have a "garment aspect," but that it was merely not a shirt or vest, in no way anticipated the district court's determinations that body-covering material, in addition to that forming the garments' pockets, was required by the patent and completely absent from Bauer's products.

regarding the procedural safeguards of our Fifth and Seventh Amendment rights as secured in FED.R.CIV.P. 56. Nor did Bauer even discuss the cases cited by DePalma which demonstrate a split in the circuits on the questions raised, cite any cases of their own, nor venture an explanation why these important questions should not be resolved by this Court. See Resp. Br. at 5.

Bauer then devotes a substantial part of its brief justifying the practice of consolidating a *Markman* hearing construing the patent claims with a motion for summary judgment of non-infringement. Resp Br. at 6-7. But the district court in this case neither merged a *Markman* claim construction hearing into the summary judgment motion nor otherwise construed DePalma's patent claims prior to rendering summary judgment, pursuant to *Markman* or otherwise. If it had done so, thereby giving the litigants prior notice of the legal claim construction upon which it would grant summary judgment, there would have been little surprise to DePalma and his case, in all probability, would not now be before this Court.

Finally, Bauer mischaracterizes DePalma's position in seeking review of the Federal Circuit rules that permit unpublished decisions and judgments without opinion, as requiring the direct application of new F.R.A.P. 32.1, effective January 1, 2007, to this case. That is hardly DePalma's position. Whether those local rules were applied here in anticipation of the new rule permitting citation to unpublished decisions, thereby proliferating no-opinion judgments in circumvention of the new rule permitting citation of unpublished opinions, or were simply means to sweep an inconsistent and unsupportable decision under the rug, this Court's supervisory role is implicated. While a lawyer should, indeed, be able to tell a court what it did, the lawyer must first know what the court did.

For the foregoing reasons, and for the reasons set out in his petition, it is respectfully submitted that DePalma's petition for a writ of certiorari be granted.

Respectfully submitted,

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